

# Utility Model Act

(Act No. 123 of April 13, 1959)

## Table of Contents

- Chapter I General Provisions (Articles 1 through 2-5)
- Chapter II Utility Model Registration and Application for Utility Model  
Registration (Articles 3 through 11)
- Chapter III Utility Model Technical Opinion (Articles 12 and 13)
- Chapter IV Utility Model Rights
  - Section 1 Utility Model Rights (Articles 14 through 26)
  - Section 2 Infringement of Rights (Articles 27 through 30)
  - Section 3 Registration Fees (Articles 31 through 36)
- Chapter V Trials and Appeals (Articles 37 through 41)
- Chapter VI Retrial and Judicial Litigation (Articles 42 through 48-2)
- Chapter VII Special Provisions Concerning International Applications Under  
the Patent Cooperation Treaty (Articles 48-3 through 48-16)
- Chapter VIII Miscellaneous Provisions (Articles 49 through 55)
- Chapter IX Penal Provisions (Articles 56 through 64)

## Chapter I General Provisions

### (Purpose)

Article 1 The purpose of this Act is to encourage the creation of devices by enabling the protection and utilization of devices associated with the shape or structure of an article or with the combination of articles, and thereby to contribute to the development of industries.

### (Definitions)

Article 2 (1) The term "device" as used in this Act refers to the creation of technical ideas utilizing the laws of nature.

(2) The term "registered utility model" as used in this Act means a device for which a utility model registration has been granted.

(3) The term "work" as used in this Act with regard to a device means an act of manufacturing, using, transferring, leasing, exporting or importing, or offering to transfer or lease an article associated with the device (including an act of displaying an article for the purpose of transfer or lease, the same applies hereinafter).

### (Amendment of Procedures)

Article 2-2 (1) A person conducting procedures connected with the registration of a utility model, such as the filing of an application for utility model registration or a request of utility model registration (hereinafter simply referred to as "procedures") may make an amendment to the application only while the case is pending before the Japan Patent Office; provided, however, that the person may not make an amendment to the description, the scope of claims for a utility model registration, drawings, or abstract accompanying the application or a document provided in Article 43, paragraph (1) of the Patent Act (Act No.121 of 1959) as applied mutatis mutandis pursuant to Article 8, paragraph (4) or Article 11, paragraph (1) (including as applied mutatis mutandis pursuant to Article 43-2, paragraph (2) as applied mutatis mutandis pursuant to Article 11, paragraph (1) (including as applied mutatis mutandis pursuant to Article 43-3, paragraph (3) of the relevant Act as applied mutatis mutandis pursuant to Article 11, paragraph (1)) and Article 43-3, paragraph 3 of the relevant Act) after a period specified by Order of the Ministry of Economy, Trade and Industry has lapsed.

(2) An amendment to the description, scope of claims for a utility model registration, or drawings pursuant to the provisions of the main clause of paragraph (1) must be made within the scope of matters stated in the description, scope of claims for a utility model registration, or drawings originally accompanying the application.

(3) Notwithstanding the provisions of paragraph (1), a corrected description, scope of claims for a utility model registration, or drawings accompanying a written correction with respect to a correction referred to in Article 14-2, paragraph (1) may not be amended.

(4) In the following cases, the Commissioner of the Japan Patent Office may order that an amendment of procedures be made by specifying a reasonable period of time:

(i) if the procedure violates the provisions of Article 7, paragraphs (1) through (3) or Article 9 of the Patent Act (Act No. 121 of 1959) as applied mutatis mutandis pursuant to Article 2-5, paragraph (2);

(ii) if the procedure violates the formalities specified by this Act or an order based on this Act;

(iii) if registration fees payable for the procedures under the provisions of Article 32, paragraph (1) have not been paid;

(iv) if fees payable for the procedures under the provisions of Article 54, paragraph (1) or (2) have not been paid;

(5) A written amendment (except in the case of a payment of registration fees or other fees) must be submitted for any procedures to be amended.

(Dismissal of a Procedure)

Article 2-3 The Commissioner of the Japan Patent Office may dismiss the procedures if the person ordered to make an amendment of procedures under the provisions of paragraph (4) of the preceding Article, Article 6-2, or Article 14-3 fails to make the amendment within a period designated under the relevant provisions.

(Capacity of Associations Which Are Not Corporations to Conduct Procedures)

- Article 2-4 (1) An association or foundation that is not a corporation but for which a representative or an administrator has been designated may undertake any of the following procedures in its own name:
- (i) file a request for a utility model technical opinion provided in Article 12, paragraph (1);
  - (ii) demand a trial or appeal;
  - (iii) demand a retrial against the final and binding trial decision.
- (2) An association or foundation that is not a corporation but for which a representative or an administrator has been designated may be named as a petitioner in a request for a retrial against a final and binding trial decision.

(Mutatis Mutandis Application of the Patent Act)

- Article 2-5 (1) The provisions of Article 3 and Article 5 of the Patent Act apply mutatis mutandis to the periods and dates provided in this Act.
- (2) The provisions of Articles 7 through 9, Articles 11 through 16, and Articles 18-2 through 24 of the Patent Act apply mutatis mutandis to procedures.
  - (3) The provisions of Article 25 of the Patent Act apply mutatis mutandis to utility model rights and other rights relating to utility model registrations.
  - (4) The provisions of Article 26 of the Patent Act apply mutatis mutandis to utility model registrations.

## **Chapter II Utility Model Registration and Application for Utility Model Registration**

(Requirements for Utility Model Registration)

- Article 3 (1) A person who created a device that relates to the shape or structure of an article or a combination of articles and is industrially applicable may obtain a utility model registration for the relevant device, excluding the following devices:
- (i) a device that is publicly known in Japan or in a foreign country, prior to the filing of the application for utility model registration;
  - (ii) a device that is publicly worked in Japan or a foreign country, prior to the filing of the application for utility model registration; or
  - (iii) a device that is stated in a distributed publication, or is made publicly

- available through electric telecommunication lines in Japan or a foreign country, prior to the filing of the application for utility model registration.
- (2) Notwithstanding the preceding paragraph, a person may not obtain a utility model registration, if a person having ordinary skill in the art of the device could have easily created the device prior to the filing of the application for a utility model registration, based on any device listed in any of the items of the preceding paragraph.

Article 3-2 If a device claimed in an application for utility model registration is identical with a device or an invention (in the case a person who created the device or invention is the same as the creator of the device claimed in the relevant application for utility model registration, excluding the device or invention) stated in the description, scope of claims for a utility model registration or scope of claims for a patent, or drawings (in the case of the written application in a foreign language referred to in Article 36-2, paragraph (2) of the Patent Act, the document in a foreign language referred to in Article 36-2, paragraph (1)) originally accompanying the application of another application for utility model registration or for patent application which has been filed prior to the filing date of the relevant application for utility model registration and published after the filing of the relevant application for utility model registration in the utility model gazette under the provisions of Article 14, paragraph (3) (hereinafter the "utility model gazette") or in the patent gazette under the provisions of Article 66, paragraph (3) of the Patent Act stating matters listed in each of the items of the respective paragraph or for which the patent application has been made open to the public, a utility model registration is not be granted for the device notwithstanding the provisions of paragraph (1) of the preceding Article; provided, however, that this does not apply if, at the time of the filing of the relevant application for utility model registration, the applicant of the relevant application and the applicant of the other application for utility model registration or for patent are the same person.

#### (Unregistrable Devices)

Article 4 Notwithstanding the provisions of Article 3, paragraph (1), no device that may harm public order, morals, or public health may not obtain a utility model registration.

#### (Provisional Non-Exclusive Licenses)

Article 4-2 (1) A person that has the right to obtain a utility model registration may grant another person a provisional non-exclusive license under the utility model rights that the person is to obtain based on the right to have that utility

model registered, within the scope of the matters indicated in the description, scope of claims for a utility model registration, or drawings originally accompanying the application for the utility model registration.

- (2) If a registration establishing utility model rights has been made in connection with an application for utility model registration to which a provisional non-exclusive license under the provisions of the preceding paragraph is linked, a non-exclusive license is deemed to have been granted under those utility model rights to the person that has that provisional non-exclusive license, to the extent permitted by the act establishing the provisional non-exclusive license.
- (3) The provisions of Article 33, paragraphs (2) and (3), Article 34-3, paragraphs (4) through (6), and paragraphs (8) through (10), and Article 34-5 of the Patent Act apply mutatis mutandis to provisional non-exclusive licenses. In this case, the phrases "Article 46, paragraph (1) with regard to an application for utility model registration to which a provisional non-exclusive license under the provisions of Article 4-2, paragraph (1) of the Utility Model Act is linked" in Article 34-3, paragraph (8) of the relevant Act and "Article 46, paragraph (2)" in paragraph (9) of the relevant Article are deemed to be replaced with "Article 10, paragraph (1) of the Utility Model Act with regard to a patent application to which a provisional non-exclusive license under the provisions of paragraph (1) or paragraph (4) of the preceding Article is linked" and "Article 10, paragraph (2) of the Utility Model Act", respectively.

#### (Applications for Utility Model Registration)

- Article 5 (1) A person seeking a utility model registration must submit an application to the Commissioner of the Japan Patent Office stating the following matters:
- (i) the name and address or residence of the applicant of a utility model registration; and
  - (ii) the name and address or residence of the creator of the device.
- (2) A description, scope of claims for a utility model registration, drawings and an abstract must accompany the application.
- (3) The description referred to in the preceding paragraph must state the following matters:
- (i) the title of the device;
  - (ii) a brief description of the drawings; and
  - (iii) a detailed description of the device.
- (4) The detailed description of the device referred to in item (iii) of the preceding paragraph must be clear and sufficient so as to enable a person having ordinary skill in the art of the device to work the device as provided by Order of the Ministry of Economy, Trade and Industry.
- (5) The applicant must state in the scope of claims for a utility model registration

referred to in paragraph (2) all the matters that the applicant finds to be necessary for identifying the device for which the applicant intends to obtain a utility model registration, separately for each claim. In this case, this does not preclude the device under one claim from being the same as the device under another claim.

(6) The description of the scope of claims for a utility model registration referred to in paragraph (2) must comply with each of the following items:

- (i) the device for which a utility model registration is sought is stated in the detailed explanation of the device;
- (ii) the device for which the utility model registration is sought is clear;
- (iii) the statement for each claim is concise; and
- (iv) other matters stated pursuant to the provisions of Order of the Ministry of Economy, Trade and Industry.

(7) The abstract referred to in paragraph (2) must summarize the device stated in the description, scope of claims for a utility model registration, or drawings, and any other matters specified by Order of the Ministry of Economy, Trade and Industry.

Article 6 A single application for utility model registration may be filed for two or more devices, provided that these devices fall under a group of devices recognized as fulfilling the requirements of the unity of devices based on their technical relationship specified by Order of the Ministry of Economy, Trade and Industry.

(Order to Amend)

Article 6-2 The Commissioner of the Japan Patent Office may order the applicant to make an amendment to the description, scope of claims for a utility model, or drawings accompanying an application, specifying a reasonable period of time, if the application for utility model registration falls under any of the following items:

- (i) if the device claimed in the application for utility model registration is not in the shape or structure of an article or a combination of articles;
- (ii) if the device claimed in the application for utility model registration is not registrable under the provisions of Article 4;
- (iii) when the application for utility model registration does not satisfy the requirements provided in Article 5, paragraph (6), item (iv) or in the preceding Article; or
- (iv) if the description, scope of claims for a utility model registration, or drawings accompanying the application do not state all of the necessary matters or is extremely unclear.

(Prior Application)

Article 7 (1) If two or more applications for utility model registration have been filed with regard to the same device on different dates, only the applicant that filed the application on the earliest date may obtain a utility model registration for the claimed device.

(2) If two or more applications for utility model registration have been filed with regard to the same device on the same date, none of the applicants is able to obtain a utility model registration for the claimed device.

(3) If a device claimed in an application for utility model registration and the invention claimed in a patent application are identical, and the applications for the utility model registration and the patent application are filed on different dates, the applicant for the utility model registration may obtain a utility model registration for the claimed device only if the application for the utility model registration is filed before the patent applicant files the patent application.

(4) If an application for utility model registration or a patent application has been abandoned, withdrawn, or dismissed, in applying the provisions of the preceding three paragraphs, the application for utility model registration or a patent application is deemed not to have been filed.

(5) If the examiner's decision or trial or appeal decision to reject a patent application has become final and binding, for the purpose of applying the provisions of paragraph (3), the patent application is to be deemed not to have been filed; provided, however, that this does not apply to cases where the examiner's decision or trial or appeal decision to reject the patent application has become final and binding on the ground that the second sentence of Article 39, paragraph (2) of the Patent Act is applicable to the relevant patent application.

(6) If no agreement is reached by discussions made under Article 39, paragraph (4) of the Patent Act or discussion cannot be held, the applicant for a utility model registration is not able to obtain a utility model registration for the device claimed.

(Claim of Priority Based on an Application for Utility Model Registration)

Article 8 (1) Except in the following cases, a person who seeks to obtain a utility model registration may claim priority for a device claimed in the application for a utility model registration, based on a device stated in the description or scope of claims for a utility model registration or patent claim, or drawings (in the case the earlier application was an application in a foreign language referred to in Article 36-2, paragraph (2) of the Patent Act, the document in a foreign language referred to in paragraph (1) of that Article) originally accompanying the application of an earlier application filed for a utility model

registration or patent for which the relevant person holds the right to obtain registration (hereinafter referred to as "earlier application"); provided, however, that if there is a person who holds a provisional exclusive license with regard to the earlier application, priority may be claimed only if the consent of the person is obtained at the time of filing the relevant application for the utility model registration:

- (i) if the relevant application for utility model registration is not filed within one year from the date of filing of the earlier application (excluding cases where the person is not found to have intentionally failed to file the application for utility model registration within one year from the date of filing, and the application was filed pursuant to Order of the Ministry of Economy, Trade and Industry within the period specified by Order of the Ministry);
  - (ii) if the earlier application is a new divisional application for utility model registration of an application for utility model registration under the provisions of Article 44, paragraph (1) of the Patent Act as applied *mutatis mutandis* pursuant to Article 11, paragraph (1), an application for utility model registration with respect to a converted application for utility model registration under Article 10, paragraph (1) or (2), a new divisional patent application with respect to a patent application under Article 44, paragraph (1) of the Patent Act, a patent application with respect to a converted patent application under Article 46, paragraph (1) or (2) of the Patent Act, or a patent application based on a utility model registration under the provisions of Article 46-2, paragraph (1) of the Patent Act;
  - (iii) at the time the application for utility model registration is filed, the earlier application had been abandoned, withdrawn, or dismissed;
  - (iv) at the time the application for the utility model registration is filed, an examiner's decision or the trial or appeal decision on the earlier application has become final and binding; and
  - (v) at the time the application for utility model registration is filed, the establishment of a utility model right provided in Article 14, paragraph (2) has been registered with respect to the earlier application.
- (2) Among devices claimed in an application for utility model registration containing a priority claim under the provisions of the preceding paragraph, for those that are stated in the description, scope of claims for a utility model registration or patent, or drawings (in the case where the earlier application was an application in a foreign language referred to in Article 36-2, paragraph (2) of the Patent Act, the document in a foreign language referred to in paragraph (1) of the relevant Article) originally accompanying the application of the earlier application on which the priority claim is based (in the case where the earlier application contains a priority claim under the provisions of



the paragraph (1) or Article 41, paragraph (1) of the Patent Act (including as applied mutatis mutandis pursuant to Article 43-3, paragraph (3) of that Act), or Article 43, paragraph (1) or Article 43-2, paragraph (1) or (2) of the Patent Act (including as applied mutatis mutandis pursuant to Article 11, paragraph (1) of Act), excluding any device stated in any documents (limited to those equivalent to the description, scope of claims for a utility model registration or patent, or drawings) submitted at the time of the filing of the application on which the priority claim in the earlier application is based), the application for utility model registration is deemed to have been filed at the time when the earlier application was filed with respect to the application of the provisions of Article 3, the main clause of Article 3-2, Article 7, paragraphs (1) through (3), Article 30, paragraphs (1) and (2) of the Patent Act as applied mutatis mutandis pursuant to Article 11, paragraph (1), Article 17, Article 69, paragraph (2), item (ii) as applied mutatis mutandis pursuant to Article 26, Article 79, Article 81, Article 82, paragraph (1), and Article 39, paragraphs (3) and (4) and Article 72 of the Patent Act, Article 26, Article 31, paragraph (2) and Article 32, paragraph (2) of the Design Act (Act No. 125 of 1959), Article 29, Article 33-2, paragraph (3) and Article 33-3, paragraph (3) of the Trademark Act (Act No. 127 of 1959) (including as applied mutatis mutandis pursuant to Article 68, paragraph (3) of the Trademark Act).

- (3) Among devices stated in the description, scope of claims for a utility model registration, or drawings originally accompanying the application for utility model registration containing a priority claim under the provisions of paragraph (1), for those that are stated in the description, scope of claims for a utility model registration or patent, or drawings (if the earlier application was an application in a foreign language referred to in Article 36-2, paragraph (2) of the Patent Act, the document in a foreign language referred to in paragraph (1) of that Article) originally accompanying the earlier application on which the priority claim is based (in the case the relevant earlier application contains a priority claim under the provisions of the preceding paragraph or Article 41, paragraph (1) of the Patent Act, Article 43-2, paragraph (1) (including as applied mutatis mutandis pursuant to Article 43-3, paragraph (3) of that Act) or Article 43-3, paragraph (1) or (2) of the Patent Act (including as applied mutatis mutandis under Article 11, paragraph (1) of this Act), excluding any device stated in any documents (limited to those equivalent to the description, scope of claims for a utility model registration or patent, or drawings) submitted at the time of the filing of the application on which the priority claim in the earlier application is based), the utility model gazette concerning the earlier application is deemed to have been issued or the utility model application is deemed to have been published at the time the utility model gazette concerning the relevant application for utility model registration was

issued so as to apply the provisions of the main clause of Article 3-2 of the Utility Model Act or Article 29-2 of the Patent Act.

- (4) A person seeking to claim priority under the provisions of paragraph (1) must submit to the Commissioner of the Japan Patent Office a document stating the fact and the indication of the earlier application within the period specified by Order of the Ministry of Economy, Trade and Industry.

(Withdrawal of an Earlier Application)

Article 9 (1) An earlier application on which a priority claim is based under the provisions of paragraph (1) of the preceding Article is deemed to have been withdrawn when a period specified by Order of the Ministry of Economy, Trade and Industry has lapsed from the filing date of the earlier application; provided, however, that this does not apply if an earlier application has been abandoned, withdrawn, or dismissed, if the examiner's decision or trial or appeal decision on the earlier application has become final and binding with regard to the application, if the establishment of the right for the earlier application provided in Article 14, paragraph (2) has been registered or if all of the claims of priority based on the earlier application have been withdrawn.

- (2) An applicant who files an application for utility model registration containing a priority claim under the provisions of paragraph (1) of the preceding Article may not withdraw the priority claim after a period specified by Order of the Ministry of Economy, Trade and Industry has lapsed from the filing date of the earlier application.

- (3) If an application for utility model registration containing a priority claim under the provisions of paragraph (1) of the preceding Article is withdrawn within a period specified by Order of the Ministry of Economy, Trade and Industry from the filing date of the earlier application, the priority claim is deemed to be withdrawn simultaneously.

(Conversion of Application)

Article 10 (1) A patent applicant may convert their patent application (other than one that has been filed based on a utility model registration under the provisions of Article 46-2, paragraph (1) of the Patent Act (this includes patent applications deemed to have been filed at the time of the filing of the original patent application under the provisions of Article 44, paragraph (2) of that Act (including as applied mutatis mutandis pursuant to Article 46, paragraph (6) of that Act))) into an application for utility model registration; provided, however, that this does not apply after three months from the date on which the certified copy of the examiner's initial decision rejecting the patent application is served or once nine years and six months have passed since the filing date of the patent application.

- (2) An applicant for design registration may convert that application for design registration (other than an application for design registration deemed to have been filed at the time of the original patent application which was filed based on an application for utility model registration under the provisions of Article 46-2, paragraph (1) of the Patent Act (including applications for design registration deemed to have been filed at the time of the filing of the original application for design registration under the provisions of Article 10-2, paragraph (2) of the Design Act) pursuant to the provisions of Article 10-2, paragraph (2) of the Design Act as applied mutatis mutandis pursuant to Article 13, paragraph (6) of the Design Act) into an application for utility model registration; provided, however, that this does not apply after three months from the date the certified copy of the examiner's initial decision rejecting the application for design registration is served, or nine years and six months have passed from the filing date of the application for design registration.
- (3) If an application is converted under the provisions of the preceding two paragraphs, the application for utility model registration is deemed to have been filed at the time that the patent application or the application for design registration was filed; provided, however, that this does not apply to the application of these provisions if the application for utility model registration falls under another application for utility model registration provided in Article 3-2 of this Act or an application for utility model registration provided in Article 29-2 of the Patent Act, and to the application of the provisions of Article 30, paragraph (3) of the Patent Act as applied mutatis mutandis pursuant to paragraph (1) of the following Article.
- (4) If an application is converted pursuant to the provisions of paragraph (1) or (2), in applying the provisions of Article 43, paragraph (2) of the Patent Act as applied mutatis mutandis pursuant to paragraph (1) of the following Article (including as applied mutatis mutandis pursuant to Article 43-2, paragraph (2) of the Patent Act as applied mutatis mutandis pursuant to paragraph (1) of the following Article (including as applied mutatis mutandis pursuant to Article 43-3, paragraph (3) of that Act) and as applied mutatis mutandis pursuant to Article 43-3, paragraph (3)), the term "within one year and four months from the earliest of the following dates" in Article 43, paragraph (2) of the Patent Act is replaced with "within one year and four months from the earliest of the following dates or three months from the filing date of the application for utility model registration related to the conversion of an application under the provisions of Article 10, paragraph (1) or (2) of the Utility Model Act, whichever comes later".
- (5) If an application is converted pursuant to the provisions of paragraph (1) or (2), the patent application or the application for design registration is deemed

to have been withdrawn.

- (6) If the period prescribed in Article 121, paragraph (1) of the Patent Act is extended pursuant to the provisions of Article 4 of that Act, the three-month period provided in the proviso to paragraph (1) is deemed to have been extended only for that extended period.
- (7) If the period prescribed in Article 46, paragraph (1) of the Design Act is extended pursuant to the provisions of Article 4 of the Patent Act as applied *mutatis mutandis* pursuant to Article 68, paragraph (1) of the Design Act, the three-month period provided in the proviso to paragraph (2) is deemed to have been extended only for that extended period.
- (8) In converting an application prescribed in paragraph (1), any documents that have been submitted in connection with the original patent application and that must be submitted in connection with a new application for utility model registration under the provisions of Article 30, paragraph (3) or Article 43, paragraphs (1) and (2) of the Patent Act as applied *mutatis mutandis* pursuant to Article 8, paragraph (4) or paragraph (1) of the following Article (including as applied *mutatis mutandis* pursuant to Article 43-2, paragraph (2) of the Patent Act as applied *mutatis mutandis* pursuant to paragraph (1) of the following Article (including as applied *mutatis mutandis* pursuant to Article 43-3, paragraph (3) of the Patent Act as applied *mutatis mutandis* pursuant to paragraph (1) of the following Article) and Article 43-3, paragraph (3)) is deemed to have been submitted to the Commissioner of the Japan Patent Office simultaneously with the new application for utility model application.
- (9) If there is a person who holds a provisional exclusive license in connection with a patent application, the patent applicant may convert that application pursuant to the provisions of paragraph (1) only with the consent of that person.
- (10) The provisions of paragraph (8) apply *mutatis mutandis* to the conversion of the application pursuant to the provisions of paragraph (2).

(*Mutatis Mutandis* Application of the Patent Act)

- Article 11 (1) The provisions of Article 30 (Exception to the Loss of Novelty of Invention), Article 38 (Joint Applications), and Articles 43 and 44 (Procedure for a Priority Claim Under the Paris Convention and Division of Patent Applications) of the Patent Act apply *mutatis mutandis* to applications for utility model registration.
- (2) The provisions of Article 33 and Article 34, paragraph (1), paragraph (2), and paragraphs (4) through (7) (Right to Obtain a Patent) of the Patent Act apply *mutatis mutandis* to the right to obtain a utility model registration.
  - (3) The provisions of Article 35 (excluding the part with respect to provisional exclusive licenses) (Employee Inventions) of the Patent Act apply *mutatis*

mutandis to devices created by employees, officers of corporations, or national or local public employees.

### **Chapter III Utility Model Technical Opinion**

(Request for Utility Model Technical Opinion)

- Article 12 (1) Any person may file a request with the Commissioner of the Japan Patent Office concerning an application for utility model registration or a utility model registration, for a technical opinion about the device claimed in that application or about the registered utility model, related to what is provided in the provisions of Article 3, paragraph (1), item (iii) and paragraph (2) (limited to the opinion on the device as set forth in Article 3, paragraph (1), item (iii)), Article 3-2, and Article 7, paragraphs (1) through (3) and paragraph (6) (hereinafter referred to as "utility model technical opinion"). In this case, concerning applications or registered utility models that contain two or more claims, such a request may be filed for each claim.
- (2) A request pursuant to the provisions of the preceding paragraph may be filed even after the utility model rights have ceased to exist; provided, however, that this does not apply if the utility model is invalidated in a trial for invalidation of utility model registration.
- (3) Notwithstanding the provisions of the preceding two paragraphs, a request pursuant to the provisions of paragraph (1) may not be filed after a patent application is filed under Article 46-2, paragraph (1) of the Patent Act which is based on that utility model registration.
- (4) When a request pursuant to the provisions of paragraph (1) is filed, the Commissioner of the Japan Patent Office must have an examiner prepare a written report on the technical opinion about a utility model (hereinafter referred to as a "report of utility model technical opinion").
- (5) The provisions of Article 47, paragraph (2) of the Patent Act apply mutatis mutandis to the preparation of a report of utility model technical opinion.
- (6) A request pursuant to the provisions of paragraph (1) may not be withdrawn.
- (7) After a request pursuant to the provisions of paragraph (1) was filed by a person that is neither the applicant for the utility model registration nor the holder of utility model rights, if a patent application pursuant to the provisions of Article 46-2, paragraph (1) of the Patent Act is filed based on the utility model registration to which the request is related (this includes a utility model registration linked to an application for utility model registration to which a request pursuant to the provisions of paragraph (1) is related), the request is deemed not to have been filed. In this case, the Commissioner of the Japan Patent Office must notify the requester to that effect.

- Article 13 (1) If a request for a utility model technical opinion is filed prior to the issuance of the utility model gazette, the Commissioner of the Japan Patent Office must publish the fact in the utility model gazette either at the time of issuance of the utility model gazette or thereafter without delay, and when such a request is filed after the issuance of the utility model gazette, without delay after the issuance of the utility model gazette.
- (2) If a request for a utility model technical opinion is filed by a person that is neither the person applying for a utility model registration nor the holder of utility model rights, the Commissioner of the Japan Patent Office must notify the applicant of the application for utility model registration or the holder of utility model rights to that effect.
- (3) Once a report of a utility model technical opinion is prepared, the Commissioner of the Japan Patent Office must serve a certified copy on the requester if the requester is either the applicant of application for the utility model registration or the holder of utility model rights and must serve a certified copy of the report of utility model technical opinion on the requester and the applicant of application for the utility model registration or the holder of utility model rights, if the requester is neither the applicant of application for the utility model registration nor the holder of utility model rights.

## **Chapter IV Utility Model Rights**

### **Section 1 Utility Model Rights**

(Registration of Establishment of Utility Model Rights)

- Article 14 (1) Utility model rights come into existence through the registration of establishment of the rights.
- (2) When an application for utility model registration has been filed, a registration establishing rights to that utility model is made, unless the application is abandoned, withdrawn, or dismissed.
- (3) Once a registration referred to in the preceding paragraph is made, the following information must be published in the utility model gazette.
- (i) the name and the address or residence of the holder of utility model rights;
  - (ii) the number and the filing date of the application for utility model registration;
  - (iii) the name and the address or residence of the creator of the device;
  - (iv) the matters stated in the description and scope of claims for the utility model registration accompanying the application and the content of the drawings accompanying that application;
  - (v) the matters stated in the abstract accompanying the application;
  - (vi) the registration number and the date of the registration establishing the utility model right; and

- (vii) beyond what is set forth in the preceding items, other necessary matters.
- (4) The provisions of Article 64, paragraph (3) of the Patent Act apply *mutatis mutandis* if the matters stated in the abstract referred to in item (v) of the preceding paragraph pursuant to the preceding paragraph are published in the utility model gazette.

(Correction of the Description, Scope of Utility Model Registration Claims, and Drawings)

- Article 14-2 (1) Except in the following cases, the holder of utility model rights may correct the description, utility model registration claims, or drawings accompanying the application, but only once:
- (i) if two months have passed from the date on which the certified copy of the first report of utility model technical opinion was served pursuant to the provisions of Article 13, paragraph (3); and
  - (ii) the period initially specified under the provisions of Article 39, paragraph (1) for a trial for invalidation of utility model registration has passed.
- (2) Any correction to be made under the preceding paragraph is limited to those for the following purposes:
- (i) restriction of the scope of utility model registration claims;
  - (ii) correction of errors;
  - (iii) clarification of an ambiguous statement; and
  - (iv) rewriting a claim that cites another claim into a claim that does not cite that other claim.
- (3) The correction referred to in paragraph (1) must remain within the scope of the matters indicated in the description, scope of utility model registration claims, and drawings accompanying the application (or, in the case of a correction for the purpose set forth in item (ii) of the preceding paragraph, the description, scope of utility model registration claims, and drawings that originally accompanied the application).
- (4) A correction referred to in paragraph (1) must not substantially expand or change the scope of utility model registration claims.
- (5) The provisions of Article 4 of the Patent Act apply *mutatis mutandis* to the period provided in paragraph (1), item (i).
- (6) Notwithstanding the provisions of paragraph (1), item (i), if a person making a correction referred to in paragraph (1) is unable to make that correction within the period provided for in item (i) due to reasons beyond that person's control, the person may make the correction within 14 days (or within two months if the applicant is an overseas resident) after the date on which the reasons cease to exist, but no later than six months after that period.
- (7) In addition to making the corrections referred to in paragraph (1), a holder of utility model rights may correct the description, scope of claims for a utility

model registration, or drawings accompanying the application as long as the correction is made for the purpose of deleting claims; provided, however, that if a trial for invalidation of utility model registration is pending before the Japan Patent Office, the description, scope of claims for a utility model registration, or drawings accompanying the application may not be corrected after a notice is given pursuant to the provisions of Article 156, paragraph (1) of the Patent Act as applied *mutatis mutandis* pursuant to Article 41 (or if the proceedings have been resumed under the provisions of Article 156, paragraph (3) of the Patent Act, after further notice is given under the provisions of Article 156, paragraph (1) of the Patent Act).

- (8) The correction referred to in paragraph (1) or the preceding paragraph may be made even after utility model rights have ceased to exist; provided, however, that this does not apply after the registration has been invalidated through a trial for invalidation of utility model registration.
- (9) A written correction must be submitted in order to make a correction referred to in paragraph (1) or (7).
- (10) The corrected description, scope of utility model registration claims, or drawings must accompany the written correction in making a correction referred to in paragraph (1).
- (11) If a correction referred to in paragraph (1) or (7) is made, the filing of the application for utility model registration and the registration that establishes the rights to the utility model are deemed to have been made based on the corrected description, scope of claims for the utility model registration, or drawings.
- (12) If a correction referred to in paragraph (1) is made, the matters stated in the corrected description, scope of utility model registration claims, and the content of the corrected drawings must be published in the utility model gazette, and if a correction referred to in paragraph (7) is made, the fact must be published in the utility model gazette.
- (13) The provisions of Article 127 and Article 132, paragraph (3) of the Patent Act apply *mutatis mutandis* to the cases under paragraphs (1) and (7).

(Order to Amend with Respect to Correction)

Article 14-3 If a written correction (limited to a correction referred to in paragraph (1) of the preceding Article) has been submitted and the matters stated in the corrected description, scope of a utility model registration claim, or drawings accompanying the written correction fall under any of the following items, the Commissioner of the Japan Patent Office may order the applicant to amend the corrected description, scope of a utility model registration claim, or drawings accompanying the written correction, by specifying a reasonable period of time:



- (i) if the device identified by the matters stated in the corrected utility model registration claims accompanying the written correction is not a device in the shape or structure of an article or combination of articles;
- (ii) if the device identified by the matters stated in the corrected scope of utility model registration claims accompanying the written correction is not registrable pursuant to the provisions of Article 4;
- (iii) if the statement of the corrected description, scope of the utility model registration claims, or drawings accompanying the written correction does not satisfy the requirements provided in Article 5, paragraph (6), item (iv) or Article 6; or
- (iv) if the corrected description, scope of utility model registration claims, or drawings accompanying the written correction do not state the necessary matters or are extremely unclear.

#### (Duration of Utility Model Rights)

Article 15 The duration of utility model rights ends ten years after the filing date of the application for the utility model registration.

#### (Effect of Utility Model Rights)

Article 16 The holder of utility model rights has the exclusive right to work the registered utility model in the course of trade; provided, however, that, if the holder establishes an exclusive license under their utility model rights, this does not apply to the extent that the exclusive licensee is licensed to exclusively work the registered utility model.

#### (Relationship with the Registered Utility Model of Another Person)

Article 17 The holder of utility model rights, exclusive licensee, or non-exclusive licensees may not work the registered utility model in the course of trade if the registered utility model uses a registered utility model, patented invention, or registered design or a design similar to it that another person has filed an application for prior to the filing date of the application for the utility model registration in question, or if the utility model rights are in conflict with design rights or trademark rights to an application that another person has filed prior to the filing date of the application for the utility model registration in question.

#### (Special Provisions on the Transfer of a Utility Model Right)

Article 17-2 (1) If a utility model registration falls under the requirements prescribed in Article 37, paragraph (1), item (ii) (but only if the utility model registration has been made in violation of the provisions of Article 38 of the Patent Act as applied mutatis mutandis pursuant to Article 11, paragraph (1))

or the requirements prescribed in Article 37, paragraph (1), item (v), the person with the right to obtain a utility model registration for the device under that utility model registration may demand that the holder of utility model rights transfer that utility model right as prescribed by Order of the Ministry of Economy, Trade and Industry.

- (2) If the transfer of a utility model right is registered based on a demand under the provisions of the preceding paragraph, the utility model right is deemed to have belonged to the person that has obtained the registration from the beginning.
- (3) The provisions of Article 73, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to Article 26 do not apply if a part of co-owned utility model rights is transferred based on a demand under the provisions of paragraph (1).

#### (Exclusive Licenses)

Article 18 (1) The holder of utility model rights may establish an exclusive license under their utility model rights.

- (2) The exclusive licensee has the exclusive right to work the registered utility model in the course of trade, to the extent permitted by the act establishing the license.
- (3) The provisions of Articles 77, paragraphs (3) through (5) (Transfer), Article 97, paragraph (2) (Waiver of Patent Rights), and Article 98, paragraph (1), item (ii), and paragraph (2) (Effect of Registration) of the Patent Act apply mutatis mutandis to exclusive licenses.

#### (Non-Exclusive Licenses)

Article 19 (1) A holder of utility model rights may grant a non-exclusive license under their utility model rights to another person.

- (2) A non-exclusive licensee has the right to work the registered utility model in the course of trade, pursuant to the provisions of this Act or to the extent permitted by the act establishing the license.
- (3) The provisions of Article 73, paragraph (1) (Joint Ownership), Article 97, paragraph (3) (Waiver of Patent Right) and Article 99 (Perfection of Non-Exclusive License) of the Patent Act apply mutatis mutandis to non-exclusive licenses.

#### (Non-Exclusive Licenses Based on the Working of the Utility Model Prior to the Registration of the Demand for a Trial for Patent Invalidation)

Article 20 (1) Before a demand for a trial for patent invalidation referred to in Article 123, paragraph (1) of the Patent Act (hereinafter simply referred to as "trial for patent invalidation" in this paragraph) is registered, if a person

falling under any of the following items has been engaging or preparing to engage in business that involves the working of an invention in Japan without knowing that the patent falls under any of the items of Article 123, paragraph (1) of the Patent Act, that person has a non-exclusive license under the utility model rights or under an exclusive license existing at the time of the invalidation of the patent, but only within the scope of the invention that the person has been working or preparing to work and within the scope of the business purpose:

- (i) the original patentee if the device under the utility model registration and the patented invention are identical and the patent is invalidated;
  - (ii) the original patentee if after the patent has been invalidated, a utility model registration is granted to the legitimate right holder of a device which is identical to that invention; or
  - (iii) in the cases referred to in items (i) or(ii), at the time the request for the trial for patent invalidation is registered, a person that has an exclusive license under the patent right under the invalidated patent, or a non-exclusive license under the patent right or the exclusive license, in the cases set forth in item (i) or (ii).
- (2) The holder of the utility model rights or exclusive licensee has a right to receive reasonable consideration from a person that holds a non-exclusive license pursuant to the provisions of the preceding paragraph.

(Award Granting a Non-Exclusive License if a Registered Utility Model is Not Worked)

Article 21 (1) If a registered utility model has not been sufficiently and continuously worked for three years or longer in Japan, a person seeking to work the registered utility model may request the holder of utility model rights or exclusive licensee to hold a discussion toward an agreement to grant the non-exclusive license; provided, however, that this does not apply unless four years have passed since the filing date of the application for the registered utility model.

- (2) If the agreement referred to in the preceding paragraph is not reached or if the discussion toward such an agreement cannot be held, the person seeking to work the registered utility model may file a request with the Commissioner of the Japan Patent Office to render an award.
- (3) The provisions of Articles 84 through 91-2 (Procedures in Connection with an Award) of the Patent Act apply mutatis mutandis to the award referred to in the preceding paragraph.

(Award Granting a Person a Non-Exclusive License to Work the Person's Own Registered Utility Model)

- Article 22 (1) If a registered utility model falls under the cases provided for in Article 17, the holder of utility model rights or the exclusive licensee may request the other person referred to in that Article to hold a discussion toward an agreement to grant the holder or exclusive licensee a non-exclusive license, or a non-exclusive license for the other person's patent rights or design rights, in order to work the registered utility model.
- (2) The other person referred to in Article 17 that was requested to hold a discussion toward an agreement referred to in the preceding paragraph may request the holder of utility model rights or the exclusive licensee that made the initial request to hold a discussion concerning the grant of a non-exclusive license, within the scope of the registered utility model that the holder or exclusive licensee seeks to work as a result of the person's agreement to grant a non-exclusive license or non-exclusive license for patent rights or design rights.
- (3) If the agreement referred to in paragraph (1) is not reached or if the discussion toward such an agreement cannot be held, the holder of utility model rights or the exclusive licensee may file a request with the Commissioner of the Japan Patent Office to render an award.
- (4) If the agreement referred to in paragraph (2) is not reached or if a discussion toward such an agreement cannot be held and a request for an award referred to in the preceding paragraph is filed, the other person that is referred to in Article 17 may file a request with the Commissioner of the Japan Patent Office to award a non-exclusive license, but only within the period that the Commissioner has specified for the person to submit a written response pursuant to the provisions of Article 84 of the Patent Act as applied *mutatis mutandis* pursuant to paragraph (7).
- (5) In the case referred to in paragraph (3) or the preceding paragraph, the Commissioner of the Japan Patent Office may not render an award to grant a non-exclusive license if granting the non-exclusive license would be unreasonably prejudicial to the interests of the other person that is referred to in Article 17, the holder of utility model rights, or the exclusive licensee.
- (6) In addition to the case provided in the preceding paragraph, in the case referred to in paragraph (4), the Commissioner of the Japan Patent Office may not render an award to grant a non-exclusive license if the Commissioner does not render an award granting the non-exclusive license with respect to the request for an award referred to in paragraph (3).
- (7) The provisions of Article 84, Article 84-2, Article 85, paragraph (1), and Articles 86 through 91-2 (Procedures in Connection with an Award) of the Patent Act apply *mutatis mutandis* to an award referred to in paragraph (3) or (4).

(Award Granting a Non-Executive License for Public Benefit)

- Article 23 (1) If the working of a registered utility model is particularly necessary for public benefit, a person seeking to work the registered utility model may request the holder of utility model rights or exclusive licensee to hold a discussion toward an agreement to grant the person a non-exclusive license.
- (2) If the agreement referred to in the preceding paragraph is not reached or the discussion toward such an agreement cannot be held, the person seeking to work the registered utility model may file a request with the Minister of Economy, Trade and Industry to render an award.
- (3) The provisions of Article 84, Article 84-2, Article 85, paragraph (1), and Articles 86 through 91-2 (Procedures in Connection with an Award) of the Patent Act apply mutatis mutandis to an award referred to in the preceding paragraph.

(Transfer of a Non-Exclusive License)

- Article 24 (1) With the exception of a non-exclusive license granted by an award referred to in Article 21, paragraph (2), Article 22, paragraph (3) or (4), or paragraph (2) of the preceding Article, Article 92, paragraph (3) of the Patent Act or Article 33, paragraph (3) of the Design Act, a non-exclusive license may be transferred only if the business linked to the working of the relevant registered utility model is also transferred, with the consent of the holder of utility model rights (or, if it is a non-exclusive license under an exclusive license, with the consent of the holder of utility model rights and the exclusive licensee), or when the transfer occurs as a result of inheritance or other general succession.
- (2) With the exception of a non-exclusive license granted by an award referred to in Article 21, paragraph (2), Article 22, paragraph (3) or (4), or paragraph (2) of the preceding Article, Article 92, paragraph (3) of the Patent Act, or Article 33, paragraph (3) of the Design Act, a non-exclusive licensee may establish a right of pledge on the non-exclusive license only with the consent of the holder of utility model rights (or, if it is a non-exclusive license under an exclusive license, with the consent of the holder of utility model rights and the exclusive licensee).
- (3) A non-exclusive license granted by an award referred to in Article 21, paragraph (2) or paragraph (2) of the preceding Article may be transferred only if the business linked to the working of the relevant registered utility model is also transferred.
- (4) A non-exclusive license granted by an award referred to in Article 22, paragraph (3), Article 92, paragraph (3) of the Patent Act, or Article 33, paragraph (3) of the Design Act is transferred if the utility model rights, patent

rights, or design rights under which the non-exclusive licensee is licensed are transferred together with the business linked to the working of the thing in question; and ceases to exist if those utility model rights, patent rights, or design rights are transferred independently of the business linked to the working of the thing in question, or if those rights cease to exist.

- (5) A non-exclusive license granted by an award referred to in Article 22, paragraph (4) is transferred together with the utility model rights, patent rights, or design rights under which the non-exclusive licensee is licensed, and ceases to exist if the utility model rights, patent rights, or design rights cease to exist.

#### (Right of Pledge)

- Article 25 (1) Unless otherwise stipulated by a contract, if a right of pledge is established on utility model rights, an exclusive license, or a non-exclusive license, the pledgee may not work the registered utility model.
- (2) The provisions of Article 96 (Extension of a Right of Pledge to the Proceeds of the Patent Right) of the Patent Act apply mutatis mutandis to a right of pledge established on utility model rights, an exclusive license or a non-exclusive license.
- (3) The provisions of Article 98, paragraph (1), item (iii) and paragraph (2) (Effect of Registration) of the Patent Act apply mutatis mutandis to a right of pledge established on utility model rights or an exclusive license.

#### (Mutatis Mutandis Application of the Patent Act)

Article 26 The provisions of Articles 69, paragraphs (1) and (2) and Articles 70 through 71-2 (Limitations of Patent Right and Technical Scope of Patented Invention), Article 73 (Co-Ownership), Article 76 (Lapse of a Patent Right in Absence of an Heir), Article 79 (Non-Exclusive License Based on Prior Use), Article 79-2 (Non-Exclusive License Based on the Working of the Invention Prior to the Registration of the Transfer of a Patent Right), Article 81, Article 82 (Non-Exclusive Licenses After the Expiration of the Duration of a Design Right), Article 97, paragraph (1) (Waiver of Patent Rights), and Article 98, paragraph (1), items (i) and (ii) (Effect of Registration) apply mutatis mutandis to utility model rights.

## **Section 2 Infringement of Rights**

#### (Right to Demand an Injunction)

Article 27 (1) A holder of utility model rights or an exclusive licensee may file a claim against a person that infringes or is likely to infringe their utility model rights or exclusive license (hereinafter referred to as the "infringer") for the

cessation or prevention of the infringement.

- (2) In filing the claim under the provisions of the preceding paragraph, the holder of utility model rights or the exclusive licensee may demand measures necessary for the prevention of infringement, including the disposal of products constituting the act of infringement (including a computer program or anything equivalent (meaning a computer program or anything equivalent provided in Article 2, paragraph (4) of the Patent Act; the same applies in the following Article); the same applies hereinafter), and the removal of equipment used to infringe..

#### (Acts Deemed to Constitute Infringement)

Article 28 The following acts are deemed to constitute infringement of a utility model right or an exclusive license:

- (i) producing a thing whose only use is in the manufacture of the article covered by the registered utility model, transferring ownership, etc. of such a thing (meaning transfer of its ownership or leasing it; this includes providing it through a telecommunications line, if it is a computer program or anything equivalent; the same applies hereinafter), importing it, or offering to transfer its ownership, etc. (including displaying it for the purpose of transferring its ownership, etc.; the same applies hereinafter) in the course of trade;
- (ii) producing, transferring ownership, etc., importing, or offering to transfer ownership, etc. in the course of trade, of a thing (other than one that is widely distributed within Japan) that is used in the manufacture of the article covered by the registered utility model, and that is essential in solving the problem the device is to solve, knowing that the relevant device is a registered utility model and that the article is used in working of the device;
- (iii) possessing the article covered by the registered utility model for the purpose of transferring its ownership, leasing it, or exporting it.

#### (Presumption of the Value of Damage)

Article 29 (1) If the holder of utility model rights or exclusive licensee files a claim for compensation for damage that the holder of utility model rights or the exclusive licensee personally incurs due to infringement, against a person that, infringes the utility model rights or the exclusive license, intentionally or due to negligence, and the infringer has transferred articles that constitute the act of infringement, the value of damage sustained by the holder of the utility model rights or the exclusive licensee may be established to be the total of the amounts set forth in each of the following items:

- (i) the amount arrived at when the amount of profit per unit for the articles that the holder of the utility model rights or the exclusive licensee would

have been able to sell if the infringement had not taken place is multiplied by that part of the quantity of articles that the person infringing the utility model rights or exclusive license has transferred (referred to as the "quantity transferred" in the following item) which does not exceed the quantity covered by the right holder's or the exclusive licensee's ability to work the device (referred to as the "workable quantity" in the item) (if there are circumstances that render the holder of the utility model rights or the exclusive licensee unable to sell a quantity of articles equivalent to all or part of the workable quantity, the workable quantity less the quantity not sellable due to those circumstances (referred to as the "specified quantity" in the item)); and

- (ii) if applicable, an amount equivalent to the amount of money that is to be received in exchange for the working of the registered utility model under the utility model right or the exclusive license, for any quantity exceeding the workable quantity which is part of the quantity transferred, or for any specified quantity which is part of the quantity transferred (except in the case where it is not found that the holder of the utility model rights would have been able to establish an exclusive license or grant a non-exclusive license under the holder's utility model rights, or that the holder of the utility model rights or exclusive licensee would have been able to grant a non-exclusive license under the exclusive licensee's exclusive license).
- (2) If a holder of utility model rights or an exclusive licensee files a claim for compensation for damage that the holder of utility model rights or exclusive licensee personally incurs due to infringement against a person that, intentionally or due to negligence, infringes the utility model rights or exclusive license, and the infringer has profited from the infringement, the amount of that profit is presumed to be the value of the damage incurred by the holder of utility model rights or the exclusive licensee.
- (3) The holder of utility model rights or the exclusive licensee may fix the value of the damage that the holder of utility model rights or the exclusive licensee has personally incurred as being equivalent to the amount of money the holder of utility model rights or the exclusive licensee would have been entitled to receive for the working of the registered utility model, and may claim compensation for this against a person that infringes the utility model rights or the exclusive license intentionally or due to negligence.
- (4) When a court determines the amount equivalent to the amount of money to be received for the working of a registered utility model as provided in paragraph (1), item (ii) or the preceding paragraph, the court may take into account the consideration that the holder of the utility model right or exclusive licensee would hypothetically obtain if they reach an agreement with the infringer, based on the premise that the utility model rights or exclusive license had been



infringed, concerning the consideration for the working of the registered utility model that is covered by their utility model right or exclusive license.

- (5) The provision of paragraph (3) does not preclude any claim to compensation for damages in excess of the amount provided for in it. In this case, in the absence of intent or gross negligence by the person that has infringed the utility model rights or the exclusive license, the court may take these circumstances into consideration in fixing the amount of damages.

(Presentation of a Report of Utility Model Technical Opinion)

Article 29-2 A holder of utility model rights or an exclusive licensee may not exercise their utility model rights or exclusive license against an infringer, etc. until after having warned the infringer, etc. by presenting a report of utility model technical opinion for that registered utility model.

(Liability of the Holder of Utility Model Rights)

Article 29-3 (1) If a trial decision invalidating a utility model registration (other than one rendered on the grounds set forth in Article 37, paragraph (1), item (vi)) becomes final and binding after a holder of utility model rights or an exclusive licensee exercises rights against an infringer, etc., or gives a warning to the infringer, etc., the holder or the exclusive licensee is liable to compensate for damage incurred by the other party as a result of the exercise of those rights or as a result of the warning; provided, however, that this does not apply if the holder or the exclusive licensee exercises those rights or gives a warning based on the utility model technical opinion that is given in the report of utility model technical opinion (other than the opinion that the device claimed in the application for utility model registration or the registered utility model cannot be registered pursuant to the provisions of Article 3, paragraph (1), item (iii) and paragraph (2) (limited to an opinion about an device as set forth in Article 3-2, and Article 7, paragraphs (1) through (3), and paragraph (6)) or with considerable care in exercising those rights or in giving the warning.

- (2) The provisions of the preceding paragraph apply *mutatis mutandis* if the holder of utility model rights or the exclusive licensee exercises rights, or gives a warning with respect to a device that has come to fall outside the scope of what is stated in the utility model registration claims at the time of the registration of establishment of the rights to the utility model, due to a correction referred to in Article 14-2, paragraph (1) or (7) that is made to the description, the scope of claims for a utility model registration, or drawings accompanying the application for the utility model registration.

(*Mutatis Mutandis* Application of the Patent Act)

Article 30 The provisions of Articles 104-2 through 105 (Obligation to Clarify Specific Circumstances; Restriction on Exercise of Rights by the Patentee; Limitation to Assertions; Submission of Documents), and Articles 105-2-11 to 106 (Opinions of Third Parties, Expert Opinion for Calculation of Damages; Approval of Reasonable Amount as the Value of Damages; Confidentiality Protective Orders; Vacating Confidentiality Protective Order; Notice of a Request to Inspect a Case Record; Suspension of Open Examination of Parties; and Measures to Restore Credibility) of the Patent Act apply mutatis mutandis to infringement of utility model rights or an exclusive license. In this case, the phrases "the following decision or trial decision has become final and binding" and "the relevant decision or trial decisions becomes final and binding" in Article 104-4 of the Patent Act are deemed to be replaced with "the trial decision set forth in item (i) becomes final and binding, or the correction set forth in item (iii) is made" and "the relevant trial decision has become final and binding, or that a correction has been made", respectively, and the phrase "a ruling or a decision on the trial or appeal ...correcting" in item (iii) of the relevant Article is deemed to be replaced with "a correction to the description referred to in Article 14-2, paragraph (1) or (7) of the Utility Model Act and as provided by Cabinet Order".

### **Section 3 Registration Fees**

#### **(Registration Fees)**

- Article 31 (1) The person that obtains a registration of establishment of utility model rights or the holder of utility model rights must pay the amount specified by Cabinet Order not exceeding 18,000 yen plus the amount specified by Cabinet Order not exceeding 900 yen per claim, for each registered utility model and for each year from the date of the registration of establishment of the utility model rights to the expiration of the duration of the utility model rights prescribed in Article 15:
- (2) The provisions of the preceding paragraph do not apply to utility model rights that belong to the national government.
- (3) Notwithstanding the provisions of paragraph (1), if utility model rights are held under co-ownership with the national government or with persons receiving a reduction of or exemption from the registration fees pursuant to the provisions of Article 32-2 or of any other laws and regulations (hereinafter referred to as a "reduction or exemption"), and their respective ownership has been agreed upon, the amount of the registration fee referred to in paragraph (1) is the sum total calculated by first multiplying the applicable registration fee provided for in that paragraph (for a person receiving a reduction or exemption, this means the amount of the registration fee after deducting the

reduction or exemption), for each co-owner other than the national government by the percentage that represents that person's ownership, and then adding together the amounts so arrived at and this sum total is the amount that the persons other than the national government must pay.

- (4) If there is a fraction of less than 10 yen in the amount of registration fees calculated under the provisions of the preceding paragraph, that fraction is to be discarded.
- (5) Payment for a registration fee referred to in paragraph (1) must be made by patent revenue stamps, pursuant to Order of the Ministry of Economy, Trade and Industry; provided, however, that cash payment may be made, if so specified by Order of the Ministry.

(Due Date for the Payment of Registration Fees)

Article 32 (1) The registration fees for each year from the first year to the third year pursuant to the provisions of Article 31, paragraph (1) must be paid in a lump sum at the same time as the filing of the application for utility model registration (or, when an application is converted under the provisions of Article 10, paragraph (1) or (2) or is divided under the provisions of Article 44, paragraph (1) of the Patent Act as applied *mutatis mutandis* pursuant to Article 11, paragraph (1), at the same time of the conversion or division of the application).

- (2) The registration fees for each year from the fourth year pursuant to the provisions of Article 31, paragraph (1) must be paid by the end of the previous year.
- (3) At the request from the person that is to pay the registration fee, the Commissioner of the Japan Patent Office may extend the period provided for in paragraph (1) by up to 30 days.
- (4) Notwithstanding the provisions of paragraph (1) and the preceding paragraph, if a person is unable to pay the registration fee within the extended period under the provisions of the preceding paragraph due to reasons beyond the control of the person, the person may pay the registration fee within 14 days (within two months, if the applicant is an overseas resident) from the date on which the reasons cease to exist, but not later than six months after the lapse of the period.

(Reduction, Exemption, or Deferment of Registration Fees)

Article 32-2 If the person that is required to pay the registration fees pursuant to the provisions of Article 31, paragraph (1) is the creator of the device claimed in the application for the utility model registration or the creator's heir, and the Commissioner of the Japan Patent Office finds that the person is having difficulty paying the registration fees due to poverty, the Commissioner

may reduce the registration fees, exempt the person from paying those registration fees, or give the person a deferment for the payment of those registration fees as prescribed by Cabinet Order.

(Late Payment of Registration Fees)

Article 33 (1) If the holder of utility model rights is unable to pay a registration fee within the period provided for in Article 32, paragraph (2) or the period for deferred payment pursuant to the provisions of Article 32-2, the holder may make a late payment for the registration fee even after the lapse of that period, if this is done within six months after the elapse of the period.

(2) A holder of utility model rights making a late payment for a registration fee pursuant to the provisions of the preceding paragraph must pay a registration surcharge in the same amount as the registration fee, in addition to the registration fee to be paid pursuant to the provisions of Article 31, paragraph (1); provided, however, that if the utility model holder is unable to pay the registration fee within the time frame provided for in Article 32, paragraph (2) or within the time frame for deferred payment as under Article 32-2 due to reasons beyond the utility model holder's control, the utility model holder is not required to pay the registration surcharge.

(3) Payment for a registration surcharge referred to in the preceding paragraph must be made by patent revenue stamps, pursuant to Order of the Ministry of Economy, Trade and Industry; provided, however, that cash payment may be made if so specified by Order of the Ministry.

(4) If a holder of utility model rights fails to pay a registration fee for each year after the fourth year pursuant to the provisions of Article 31, paragraph (1) and the registration surcharge that must be paid pursuant to paragraph (2) within the period during which the holder is permitted to make a late payment for a registration fee pursuant to the provisions of paragraph (1), the utility model rights are deemed to have ceased to exist retroactive to the lapse of the period provided in Article 32, paragraph (2).

(5) If the holder of utility model rights fails to pay a registration fee whose payment has been deferred pursuant to the provisions of the preceding Article and the registration surcharge that must be paid pursuant to paragraph (2) within the period during which the holder is permitted to make a late payment for a registration fee pursuant to the provisions of paragraph (1), the utility model rights are deemed not to have existed from the beginning.

(Restoration of Utility Model Rights Through Late Payment of Registration Fees)

Article 33-2 (1) The original holder of utility model rights that are deemed to have ceased to exist pursuant to the provisions of paragraph (4) of the

preceding Article, or that are deemed not to have existed from the beginning pursuant to the provisions of Article 33, paragraph (5) may make a late payment for the registration fee and the registration surcharge provided in paragraph (4) or (5) of that Article pursuant to Order of the Ministry of Economy, Trade and Industry within two months after the day on which the original holder becomes able to pay the registration fee and the registration surcharge, but not later than one year after the expiration of the period during which the original holder is permitted to make a late payment for a registration fee pursuant to Article 33, paragraph (1); provided, however, that this does not apply if the original holder is found to have intentionally failed to pay the registration fee and the registration surcharge within the time frame during which the original holder is permitted to make a late payment for a registration fee pursuant to Article 33, paragraph (1).

- (2) If the registration fees and the registration surcharge under the preceding paragraph are paid, the utility model rights are deemed to have continued to exist retroactive to the time the period lapsed as provided in Article 32, paragraph (2) or to have existed from the beginning.

(Restriction on the Effect of Restored Utility Model Rights)

Article 33-3 (1) If utility model rights are restored pursuant to paragraph (2) of the preceding Article, the utility model rights are not effective against an article covered by the registered utility model which was imported into or manufactured or acquired within Japan after the lapse of the period during which the holder is permitted to make a late payment for registration fees pursuant to the provisions of Article 33, paragraph (1) and before the restoration of the utility model rights is registered.

- (2) Utility model rights that have been restored pursuant to paragraph (2) of the preceding Article are not effective on the following actions performed after the lapse of the period during which the holder is permitted to make a late payment for a registration fee pursuant to Article 33, paragraph (1) and before the restoration of the utility model rights is registered:

- (i) working the device;
- (ii) producing, transferring ownership, etc., importing, or offering to transfer ownership, etc. of a thing used to manufacture the article covered by the registered utility model; and
- (iii) possessing the article covered by the registered utility model for the purpose of transferring its ownership, leasing it or exporting it.

(Refunding of Registration Fees)

Article 34 (1) Registration fees are returned to the person who paid them, limited to the following fees, upon request by that person:

- (i) registration fees paid in error or in excess;
  - (ii) registration fees for which a disposition to dismiss the application for utility model registration becomes final and binding;
  - (iii) annual registration fees for each year following the year in which a trial decision invalidating the utility model registration becomes final and binding; and
  - (iv) annual registration fees for each year following the year in which the duration of the utility model right expires.
- (2) A request for a refund of a registration fee pursuant to the provisions of the preceding paragraph may not be filed once one year has passed since the date that the registration fee referred to in item (i) of the preceding paragraph was paid; once six months have passed since the date on which the disposition or trial decision became final and binding regarding a registration fee referred to in item (ii) or (iii) of that paragraph; or once one year has passed since the date on which the registration on establishment of the utility model rights regarding a registration fee referred to in item (iv) of that paragraph is made.
- (3) When a person requesting the refund of the registration fee pursuant to the provisions of paragraph (1) cannot make the request within the period prescribed in the preceding paragraph for reasons beyond the control of the person, notwithstanding the provisions of paragraph (1), the person may file a request within 14 days (or within two months, if the person is an overseas resident) from the date on which the reasons cease to exist, but no later than six months after the lapse of the period.

#### Article 35 Deleted

(Mutatis Mutandis Application of the Patent Act)

Article 36 The provisions of Article 110 of the Patent Act (Payment of Patent Fees by a Person Other Than a Person That Is to Pay the Patent Fees) apply mutatis mutandis to registration fees.

### Chapter V Trials and Appeals

(Trial for Invalidation of Utility Model Registration)

Article 37 (1) If a utility model registration falls under any of the following items, a request for a trial for invalidation of utility model registration may be filed. In this case, if the request involves two or more claims, it may be filed on a claim-by-claim basis.

- (i) the utility model registration has been granted concerning an application for utility model registration with an amendment that does not comply with the requirements provided for in Article 2-2, paragraph (2);

- (ii) the utility model registration has been granted in violation of the provisions of Article 25 of the Patent Act as applied mutatis mutandis pursuant to Article 2-5, paragraph (3), the provisions of Article 3, Article 3-2, Article 4, Article 7, paragraphs (1) through (3), or paragraph (6), or the provisions of Article 38 of the Patent Act as applied mutatis mutandis pursuant to Article 11, paragraph (1) (if the utility model registration has been granted in violation of Article 38 of the provisions of the Patent Act as applied mutatis mutandis pursuant to Article 11, paragraph (1) of this Act, this excludes a case in which the transfer of the utility model rights related to the utility model registration has been registered based on a request under the provisions of Article 17-2, paragraph (1));
  - (iii) the utility model registration has been granted in violation of a treaty;
  - (iv) the utility model registration has been granted concerning an application for utility model registration that does not comply with the requirements provided for in Article 5, paragraph (4) or (6) (excluding item (iv));
  - (v) the utility model registration has been granted on an application for utility model registration filed by a person with no right to obtain a utility model registration for the device (excluding when the transfer of the utility model rights under the utility model registration has been registered based on a request under the provisions of Article 17-2, paragraph (1));
  - (vi) after being granted the utility model registration, the holder of utility model rights has come to fall under a category of person that is not permitted the enjoyment of utility model rights pursuant to Article 25 of the Patent Act as applied mutatis mutandis pursuant to Article 2-5, paragraph (3), or the utility model registration has come to violate a treaty; or
  - (vii) a correction to the description, utility model registration claims, or drawings attached to the application for the utility model registration has been made in violation of the provisions of Article 14-2, paragraphs (2) through (4).
- (2) Any person may file a request for a trial for invalidation of utility model registration; provided, however, that if a request is filed for a trial for invalidation of utility model registration on the grounds that the utility model registration falls under item (ii) of the preceding paragraph (limited to a case in which the utility model registration has been made in violation of Article 38 of the Patent Act as applied mutatis mutandis pursuant to Article 11, paragraph (1)) or item (v) of the preceding paragraph, only a person with the right to obtain a utility model registration for the device related to the utility model registration may file a request for a trial.
- (3) A request for a trial for invalidation of utility model registration may be filed even after the lapse of the utility model rights.
- (4) If a request for a trial for invalidation of utility model registration is filed, the

chief administrative judge must notify the exclusive licensee with the utility model rights and other persons with rights that have been registered in connection with those utility model rights of the fact.

(Formality Requirements for Request for a Trial)

Article 38 (1) A person filing a request for a trial must submit a written request stating the following information to the Commissioner of the Japan Patent Office:

- (i) the name and the domicile or residence of the party and their agent;
- (ii) an indication of the trial case; and
- (iii) the object of the claim and the grounds for the request.

(2) In the grounds for the request that are set forth in item (iii) of the preceding paragraph, the facts that are the basis for invalidating the utility model registration must be concretely identified, and the relationship with the evidence for each fact required to be proved must be stated.

(Amendment of a Written Request for Trial)

Article 38-2 (1) The amendment of a written request submitted pursuant to paragraph (1) of the preceding Article must not change its gist; provided, however, that this does not apply if the amendment is permitted by a chief administrative judge pursuant to the provisions of the following paragraph.

(2) If the amendment of the grounds for the request set forth in paragraph (1), item (iii) of the preceding Article changes its gist of those grounds, the chief administrative judge may rule to permit the amendment upon finding there is clearly no risk that the amendment will unreasonably delay the proceedings and that the circumstances fall under any of the following items:

- (i) a request for correction as referred to in Article 14-2, paragraph (1) has been filed and the request for correction has made it necessary to amend the grounds for the demand; and
- (ii) there are reasonable grounds other than what is set forth in in the preceding item for not stating the grounds for the request for the amendment in the written request at the time the request for the trial was filed, and the demandee agrees to the amendment.

(3) Permission for the amendment referred to in the preceding paragraph may not be made if the written amendment for that amendment is submitted prior to the service of a duplicate of the written request under the provisions of paragraph (1) of the following Article.

(4) No appeal may be filed against the ruling referred to in paragraph (2) or its inaction.

(Submission of a Written Reply)



- Article 39 (1) Once a request for trial is filed, the chief administrative judge must serve a duplicate of the written request on the demandee and give the demandee an opportunity to submit a written reply by specifying a reasonable period of time.
- (2) If the chief administrative judge permits the amendment of a written request pursuant to the provisions of Article 38-2, paragraph (2), the judge must serve a duplicate of the written amendment on the demandee, and give the demandee an opportunity to submit a written reply by specifying a reasonable period of time; provided, however, that this does not apply if special circumstances exist under which it is recognized that giving the demandee an opportunity to submit a written reply is not necessary.
- (3) Once the chief administrative judge accepts a written reply referred to in paragraph (1) or the main clause of the preceding paragraph, or once a correction referred to in Article 14-2, paragraph (1) or (7) has been made while a trial for invalidation of utility model registration is pending at the Japan Patent Office, the chief administrative judge must serve a duplicate of the written reply on the demandant.
- (4) The chief administrative judge may make an inquiry to the parties and any intervenors in connection with the trial.
- (5) If a patent application under the provisions of Article 46-2, paragraph (1) of the Patent Act is filed based on the utility model registration after a request is filed for a trial for invalidation of utility model registration, the chief administrative judge must notify the demandant and the intervenors to that effect.

(Withdrawal of Request For Trial)

- Article 39-2 (1) A request for trial may be withdrawn up until the time the trial decision becomes final and binding.
- (2) Once the written reply referred to in paragraph (1) of the preceding Article has been submitted, the request for trial may not be withdrawn without the consent of the adverse party.
- (3) Notwithstanding the provisions of the preceding paragraph, if the demandant receives a notice under the provisions of paragraph (5) of the preceding Article, the demandant may withdraw the demand for trial or appeal but only within 30 days from the date on which the demandant received the notice.
- (4) The provisions of Article 4 of the Patent Act apply mutatis mutandis to the period provided for in the preceding paragraph. In this case, the term "The Commissioner of the Japan Patent Office" in that Article is deemed to be replaced with "The chief administrative judge".
- (5) Notwithstanding the provisions of paragraph (3), if the demandant is unable to withdraw the request for trial or appeal within the period provided for in

that paragraph due to reasons beyond the demandant's control, the demandant may file the request within 14 days (or within two months, if the demandant is an overseas resident) from the date on which those reasons cease to exist, but no later than six months after the end of the aforementioned period.

- (6) If a request for a trial for invalidation of utility model registration is filed concerning two or more claims in a utility model registration related to two or more claims, the request may be withdrawn on a claim-by-claim basis.

(Connection with Litigation)

Article 40 (1) If it is found to be necessary during a trial, the trial proceedings may be suspended until a trial decision for another trial before the Japan Patent Office becomes final and binding or until litigation proceedings are concluded.

- (2) If a civil action has been instituted or a motion has been filed for an order of provisional seizure or an order of provisional disposition and the court finds it to be necessary, the court may suspend litigation proceedings until a trial decision by the Japan Patent Office becomes final and binding.
- (3) The court is to notify the Commissioner of the Japan Patent Office if an action is instituted with respect to the infringement of utility model rights or an exclusive license. The same applies once the litigation proceedings are concluded.
- (4) If the Commissioner of the Japan Patent Office receives a notice under the preceding paragraph, the Commissioner is to notify the court of whether a request for trial has been filed with the Office with regard to the utility model rights. The same applies when the Office issues a ruling dismissing the written demand for such a trial, or renders the trial decision, or if the request for such a trial is withdrawn.
- (5) If the court is notified pursuant to the preceding paragraph that a request for a trial has been filed with regard to the relevant utility model rights, and if a document stating the method of allegation or defense pursuant to the provisions of Article 104-3, paragraph (1) of the Patent Act as applied *mutatis mutandis* pursuant to Article 30 has already been submitted in the litigation before that notice is given, or the document is submitted for the first time after that notice is given, the court must notify the Commissioner of the Japan Patent Office of the fact.
- (6) If the Commissioner of the Japan Patent Office receives a notice provided in the preceding paragraph, the Commissioner may request the court to send a copy of any record of the litigation that the administrative judge finds to be necessary for the trial.

(*Mutatis Mutandis* Application of the Patent Act)

Article 41 The provisions of Article 125, Articles 132 through 133-2, Articles 135 through 154, Article 156, paragraphs (1), (3), and (4), Article 157, Article 167, Article 167-2, Article 169, paragraphs (1), (2), (5), and (6), and Article 170 of the Patent Act apply mutatis mutandis to trials. In this case, the phrase "When a case... in a trial other than a trial for patent invalidation" in Article 156, paragraph (1) of that Act is deemed to be replaced with "When a case".

## **Chapter VI Retrial and Judicial Litigation**

### **(Request for Retrial)**

Article 42 (1) A party or an intervenor may file a request for a retrial against a final and binding trial decision.

(2) The provisions of Article 338, paragraphs (1) and (2) and Article 339 (Grounds for Retrial) of the Code of Civil Procedure (Act No. 109 of 1996) apply mutatis mutandis to a request for a retrial referred to in the preceding paragraph.

Article 43 (1) If a demandant and demandee in a trial before the Japan Patent Office have conspired to bring about the trial decision with the aim of harming the rights or interests of a third party, the third party may file a request a retrial against the final and binding trial decision.

(2) A request for a retrial referred to in the preceding paragraph must be filed against the demandant and the demandee in the trial as the jointdemandees.

### **(Limitations on the Effect of a Utility Model Rights Restored on Retrial)**

Article 44 (1) If utility model rights under an invalidated utility model registration has been restored by retrial, the effect of the utility model rights does not extend to any relevant article covered by the registered utility model that was imported into or manufactured or acquired within Japan in good faith, after the trial decision becomes final and binding and before the request for a retrial was registered.

(2) If utility model rights under an invalidated utility model registration are restored by retrial, the effect of the utility model rights does not extend to the following actions performed after the trial decision becomes final and binding but before the request for a retrial was registered:

- (i) working of the device in good faith;
- (ii) producing, transferring ownership, etc., importing, or offering to transfer, etc., of a thing used to manufacture the article covered by the registered utility model in good faith; and
- (iii) possessing the article covered by the registered utility model, for the purpose of transferring, leasing, or exporting it in good faith.

(Mutatis Mutandis Application of the Patent Act)

- Article 45 (1) Article 173 (Period for Filing a Request for a Retrial), Article 174, paragraphs (3) and (5) (Mutatis Mutandis Application of Provisions on Trials and Appeals), and Article 176 (Non-Exclusive License Based on the Working of the Invention Prior to the Registration of the Request for a Retrial) of the Patent Act apply mutatis mutandis to retrials. In this case, the phrases "Article 131, paragraph (1), the main clause of Article 131-2, paragraph (1)", "Article 134, paragraphs (1), (3), and (4)" and "and Article 168" in Article 174, paragraph (3) of the Patent Act are deemed to be replaced with "Article 38, paragraph (1), the main clause of Article 38-2, paragraph (1) of the Utility Model Act", "Article 39, paragraphs (1), (3), and (4) of the Utility Model Act", and "Article 167-2, Article 40 of the Utility Model Act", respectively.
- (2) The provisions of Article 4 of the Patent Act apply mutatis mutandis to the period provided for in Article 173, paragraph (1) of that Act as applied mutatis mutandis pursuant to the preceding paragraph.

Article 46 Deleted

(Revocation Actions Against Trial Decisions)

- Article 47 (1) The Tokyo High Court has exclusive jurisdiction over any revocation action against a trial decision or a ruling dismissing a written request for a trial, or a retrial.
- (2) The provisions of Article 178, paragraphs (2) through (6) (Statute of Limitations for Filing an Action), Articles 179 through 182-2 (Eligibility for Defendant; Notice of Filing of an Action; Opinion of the Commissioner of the Japan Patent Office in a Revocation Action against a Trial Decision; Revoking a Trial Decision or a Ruling; Sending of the Original Copy of the Judicial Decision. and Composition of a Panel) of the Patent Act apply mutatis mutandis to an action referred to in the preceding paragraph.

(Revocation Actions Against the Amount of Consideration)

- Article 48 (1) If a person that has received an award referred to in Article 21, paragraph (2), Article 22, paragraph (3) or (4), or Article 23, paragraph (2) is not satisfied with the amount of consideration determined in the award, that person may institute an action demanding an increase or decrease in that amount.
- (2) The provisions of Article 183, paragraph (2) (Statute of Limitations for Filing an Action) and Article 184 (Eligibility for Defendant) of the Patent Act apply mutatis mutandis to an action referred to in the preceding paragraph.

(Relationship Between Objection and Litigation)

## **Chapter VII Special Provisions Concerning International Applications Under the Patent Cooperation Treaty**

(The Filing of an Application for Utility Model Registration Through an International Application)

Article 48-3 (1) An international application (limited to an application for utility model registration) to which an international filing date is accorded based on the provisions of Article 11 (1), Article 11 (2)(b), or Article 14 (2) of the Patent Cooperation Treaty Done at Washington on June 19, 1970 (hereinafter referred to as the "Treaty" in this Chapter) and which includes Japan as a designated State under Article 4 (1)(ii) of the Treaty is deemed to be an application for utility model registration filed on the international filing date.

(2) The provisions of Article 184-3, paragraph (2) (The Filing of a Patent Application Through an International Application) of the Patent Act apply *mutatis mutandis* to the filing of an international application that is deemed to be an application for utility model registration pursuant to the provisions of the preceding paragraph (hereinafter referred to as "international application for utility model registration").

(Translations of International Applications for Utility Model Registration Filed in a Foreign Language)

Article 48-4 (1) An applicant filing an international application for utility model registration in a foreign language (hereinafter referred to as "foreign language application for utility model registration") must submit Japanese translations of the description, claims, drawings (limited to the descriptive text in the drawings; hereinafter the same applies in this Article), and the abstract, provided for in Article 3 (2) of the Treaty, on the international filing date provided for in paragraph (1) of the preceding Article (hereinafter referred to as the "international filing date") to the Commissioner of the Japan Patent Office, within two years and six months (hereinafter referred to as the "period for the submission of national documents") from the priority date referred to in Article 2 (xi) of the Treaty (hereinafter referred to as the "priority date"); provided, however, that the applicant filing a foreign language application for utility model registration that has submitted the document provided for in paragraph (1) of the following Article in the period between two months before the expiration of the period for submitting national documents and the expiration of that period (unless the translations have been submitted prior to the submission of those documents) may submit the relevant translations within two months from the date of submission of those documents (hereinafter

- referred to as the "exception period for the submission of translations").
- (2) In the case referred to in the preceding paragraph, if the applicant filing the foreign language application for utility model registration makes an amendment based on the provisions of Article 19 (1) of the Treaty, the applicant may submit a translation of the amended claims in lieu of submitting a translation of the claims as provided in the preceding paragraph.
  - (3) If the translation of the description provided for in paragraph (1) and the translation of the claims provided for in the preceding two paragraphs (hereinafter referred to as the "translations of the description, etc.") have not been submitted within the period for submitting national documents (or, if the application is a foreign language application for utility model registration referred to in the proviso to paragraph (1), within the exception period for submitting translations; hereinafter the same applies in this Article), the international application for utility model registration is deemed to have been withdrawn.
  - (4) An applicant filing an international application for utility model registration that is deemed to have been withdrawn pursuant to the provisions of the preceding paragraph may submit the translation of the description, and the translations of the drawings and the abstract provided in paragraph (1) to the Commissioner of the Japan Patent Office pursuant to Order of the Ministry of Economy, Trade and Industry within two months after the date on which the applicant becomes able to submit the translation of the description, etc., but not later than one year after the expiration of the period for submitting national documents; provided, however, that this does not apply if the applicant is found to have intentionally failed to submit the translation of the description, etc. within the period for submitting national documents.
  - (5) Translations submitted under the provisions of the preceding paragraph are deemed to have been submitted to the Commissioner of the Japan Patent Office at a time just before the period for submitting national documents expires.
  - (6) If an applicant submitting the translation of the claims provided for in paragraph (1) makes an amendment based on the provisions of Article 19 (1) of the Treaty, the applicant may further submit a Japanese translation of the amended claims no later than the date on which the period for submitting national documents expires (or, if the applicant makes a request under the provisions of Article 23 (2) or Article 40 (2) of the Treaty within the period for submitting national documents (hereinafter referred to as "request for national processing"), at the time of filing the request for national processing (hereinafter referred to as "at the standard time for national processing")).
  - (7) The provisions of the main clause of Article 184-7, paragraph (3) of the Patent Act apply *mutatis mutandis* if the translation provided for in paragraph (2) or the preceding paragraph is not submitted.

(Submission of Documents and Order to Amend Procedures)

Article 48-5 (1) An applicant filing an international application for utility model registration must submit a document stating the following information to the Commissioner of the Japan Patent Office within the period for submitting national documents:

- (i) the name, and the address or residence of the applicant;
- (ii) the name, and the address or residence of the creator of the device; and
- (iii) the international application number and other matters specified by Order of the Ministry of Economy, Trade and Industry.

(2) In the following cases, the Commissioner of the Japan Patent Office may order that an amendment of procedures be made by specifying a reasonable period of time:

- (i) the document that must be submitted pursuant to the provisions of the preceding paragraph is not submitted within the period for submitting national documents;
- (ii) the procedure under the provisions of the preceding paragraph violates the provisions of Article 7, paragraphs (1) through (3) or Article 9 of the Patent Act as applied mutatis mutandis pursuant to Article 2-5, paragraph (2);
- (iii) the procedure under the provisions of the preceding paragraph violates the formalities specified by Order of the Ministry of Economy, Trade and Industry;
- (iv) the translation of the abstract to be submitted pursuant to the provisions of paragraph (1) of the preceding Article is not submitted within the period for submitting national documents (or, if the application is a foreign language application for utility model registration referred to in the proviso to paragraph (1) of the preceding Article, within the exception period for submitting translations);
- (v) a registration fee to be paid pursuant to Article 32, paragraph (1) is not paid within the period for submitting national documents;
- (vi) a fee to be paid pursuant to the provisions of Article 54, paragraph (2) is not paid within the period for submitting national documents.

(3) The provisions of Article 184-5, paragraph (3) of the Patent Act apply mutatis mutandis to an amendment that is based on an order under the provisions of the preceding paragraph.

(4) An applicant filing an international application for utility model registration may not file a request for national processing, concerning an international application for utility model registration filed in the Japanese language (hereinafter referred to as a "Japanese language application for utility model registration") until after conducting the procedure under paragraph (1), may not file a request for national processing with respect to a foreign language

application for utility model registration until after conducting procedures under the provisions of paragraph (1) and paragraph (1) of the preceding Article, and may not file a request for national processing concerning either application until after paying the registration fees to be paid pursuant to the provisions of Article 32, paragraph (1) and the provisions of Article 54, paragraph (2).

(Effect of the Application or Description in an International Application)

Article 48-6 (1) The application in an international application for utility model registration as of the international filing date is deemed to be an application submitted pursuant to the provisions of Article 5, paragraph (1).

(2) The description as of the international filing date of a Japanese language application for utility model registration, and the translation of the description as of the international filing date of a foreign language application for utility model registration are deemed to be the descriptions submitted with the application pursuant to the provisions of Article 5, paragraph (2); the utility model registration claims as of the international filing date of a Japanese language application for utility model registration and the translation of the claims as of the international filing date of a foreign language application for utility model registration are deemed to be the claims submitted with the application pursuant to the provisions of that paragraph; the drawings as of the international filing date of a Japanese language application for utility model registration, and the drawings (other than the descriptive text in the drawings) and the translation of the descriptive text in the drawings as of the international filing date of a foreign language application for utility model registration are deemed to be the drawings submitted with the application pursuant to the provisions of that paragraph; and the abstract of the Japanese language application for utility model registration or the translation of the abstract of a foreign language application for utility model registration is deemed to be the abstract submitted with the application pursuant to the provisions of that paragraph.

(3) Notwithstanding the provisions of the preceding paragraph, if a translation of the claims as amended based on the provisions of Article 19 (1) of the Treaty is submitted pursuant to the provisions of Article 48-4, paragraph (2) or (6), the claims are deemed to be the utility model registration claims submitted with the application by attaching the translation of the amended claims pursuant to the provisions of Article 5, paragraph (2).

(Submission of Drawings)

Article 48-7 (1) If an international application for utility model registration does not include a drawing on the international filing date, the applicant must



submit the drawing to the Commissioner of the Japan Patent Office within the standard time for national processing.

- (2) If a drawing as under the provisions of the preceding paragraph is not submitted within the standard time for national processing, the Commissioner of the Japan Patent Office may order the applicant filing the international application for utility model registration to submit the drawing by specifying a reasonable period of time.
- (3) If a person ordered to submit a drawing pursuant to the provisions of the preceding paragraph does not submit the drawing within the period of time that the Commissioner of the Japan Patent Office has specified pursuant to the provisions of that paragraph, the Commissioner may dismiss the relevant international application for utility model registration.
- (4) The submission of a drawing pursuant to the provisions of paragraph (1) or based on the order under the provisions of paragraph (2) (if a brief description of the drawing is submitted with the drawing, this means the submission of the drawing and the description) is deemed to be an amendment of procedures under the provisions of Article 2-2, paragraph (1). In this case, the provisions of the proviso to Article 2-2, paragraph (1) do not apply.

(Special Provisions on Amendment)

- Article 48-8 (1) The provisions of the proviso to Article 2-2, paragraph (1) do not apply to the amendment that is deemed to be an amendment under the provisions of Article 184-7, paragraph (2) of the Patent Act as applied *mutatis mutandis* pursuant to Article 48-15, paragraph (1), and that is deemed to be an amendment under the provisions of Article 2-2, paragraph (1) pursuant to Article 184-8, paragraph (2) of the Patent Act.
- (2) The provisions of the proviso to Article 2-2, paragraph (1) do not apply to the amendment of an international application for utility model registration based on the provisions of Article 28 (1) or Article 41 (1) of the Treaty.
  - (3) Concerning the allowable scope of amendment to the description, utility model registration claims, or drawings in a foreign language application for utility model registration, the phrase "the description, scope of claims of a utility model registration, or drawings originally accompanying the application" in Article 2-2, paragraph (2) is deemed to be replaced with "the description, claims, or drawings in the international application as of the international filing date referred to in Article 48-4, paragraph (1)".
  - (4) The provisions of Article 184-12, paragraph (1) of the Patent Act apply *mutatis mutandis* to the amendment of an international application for utility model registration based on the main clause of Article 2-2, paragraph (1) or based on the provisions of Article 28 (1) or Article 41 (1) of the Treaty. In this case, the term "Article 195, paragraph (2)" in Article 184-12, paragraph (1) of

the Patent Act is deemed to be replaced with "registration fees required to be paid pursuant to the provisions of Article 32, paragraph (1) of the Utility Model Act and Article 54, paragraph (2) of that Act", and the phrase "has been paid, and the standard time for national processing has passed" is deemed to be replaced with "has been paid".

(Special Provisions on Requirements for Utility Model Registration)

Article 48-9 In applying the provisions of Article 3-2 to a case in which another application for utility model registration as provided in Article 3-2 or a patent application as provided in that Article is an international application for utility model registration or an international patent application referred to in Article 184-3, paragraph (2) of the Patent Act, the phrase "in another application for utility model registration or for patent application" in that Article is deemed to be replaced with "in another application for utility model registration or in a patent application (other than one that is a foreign language application for utility model registration referred to in Article 48-4, paragraph (1) of the Utility Model Act or a foreign language patent application referred to in Article 184-4, paragraph (1) of the Patent Act, and which is deemed to have been withdrawn pursuant to Article 48-4, paragraph (3) of the Utility Model Act or Article 184-4, paragraph (3) of the Patent Act)"; the term "the issuance or" in that Article is deemed to be replaced with "the issuance", the phrase "or the patent application has been published" is deemed to be replaced with "or the patent application has been published, or the international publication provided in Article 21 of the Patent Cooperation Treaty Done at Washington on June 19, 1970 is effected", and the phrase "the description, claims for a utility model registration, or drawings originally accompanying the written application" in that Article is deemed to be replaced with "the description, claims, or drawings in an international application, as of the international filing date referred to in Article 48-4, paragraph (1) of this Act or Article 184-4, paragraph (1) of the Patent Act".

(Special Provisions on Priority Claims Based on Applications for Utility Model Registration)

- Article 48-10 (1) The provisions of the proviso to Article 8, paragraph (1), Article 8, paragraph (4), and Article 9, paragraph (2) do not apply to an international application for utility model registration.
- (2) In applying the provisions of Article 8, paragraph (3) to a Japanese language application for utility model registration, the phrase "at the time that the application for utility model registration is published in the utility model gazette in which the utility model appears" in that paragraph is deemed to be replaced with "at the time that the application for the utility model

registration is published in the utility model gazette in which the utility model appears or at the time that the international publication prescribed in Article 21 of the Patent Cooperation Treaty Done at Washington on June 19, 1970 is effected".

- (3) In applying the provisions of Article 8, paragraph (3) to a foreign language application for utility model registration, the phrase "in the description, scope of claims of utility model registration, or drawings originally accompanying the application for utility model registration" is deemed to be replaced with "in the description, claims, or drawings in an international application as of the international filing date referred to in Article 48-4, paragraph (1)", and the phrase "at the time that the application for the utility model registration is published in the utility model gazette in which the utility model appears" is deemed to be replaced with "at the time that the application for the utility model registration is published in the utility model gazette or at the time that the international publication prescribed in Article 21 of the Patent Cooperation Treaty Done at Washington on June 19, 1970 is effected".
- (4) In applying the provisions of Article 8, paragraphs (1) through (3) and Article 9, paragraph (1), if an earlier application referred to in Article 8, paragraph (1) is an international application for a utility model registration or an international patent application referred to in Article 184-3, paragraph (2) of the Patent Act, the phrase "the description, scope of claims of a utility model registration or a patent claim, or drawings originally accompanying the application" in Article 8, paragraphs (1) and (2) is deemed to be replaced with "the description, claims, or drawings in an international application as of the international filing date referred to in Article 48-4, paragraph (1) or Article 184-4, paragraph (1) of the Patent Act", the phrase "the description, scope of claims of a utility model registration claim, a patent claim, or drawings originally accompanying the application in the earlier application" in Article 8, paragraph (3) is deemed to be replaced with "the description, claims, or drawings in an international application as of the international filing date referred to in Article 48-4, paragraph (1) or Article 184-4, paragraph (1) of the Patent Act", the phrase "has been published" in Article 8, paragraph (3) is deemed to be replaced with "the international publication provided in Article 21 of the Patent Cooperation Treaty Done at Washington on June 19, 1970 is effected", and the phrase "when a period specified by Order of the Ministry of Economy, Trade and Industry has lapsed from the application date" in Article 9, paragraph (1) is deemed to be replaced with "at the standard time for national processing referred to in Article 48-4, paragraph (6) or Article 184-4, paragraph (6) of the Patent Act or at the time when a period specified by Order of the Ministry has passed from the international filing date referred to in Article 48-4, paragraph (1) or Article 184-4, paragraph (1) of the Patent Act, whichever is

later".

(Special Provisions on Conversion of Applications)

Article 48-11 Concerning the conversion of an international application that is deemed to be a patent application pursuant to the provisions of Article 184-3, paragraph (1) or Article 184-20, paragraph (4) of the Patent Act to a Japanese language patent application for utility model registration, if the international application is a Japanese language patent application referred to in Article 184-6, paragraph (2), it may not be converted until the procedures in Article 184-5, paragraph (1) of that Act have been undertaken, or if the international application is a foreign language patent application referred to in Article 184-4, paragraph (1), it may not be converted until the procedures in that paragraph or paragraph (4) of that Article and of Article 184-5, paragraph (1) of the Act have been undertaken, and in both cases, the application may not be converted into an application for utility model registration until after the fees required to be paid pursuant to Article 195, paragraph (2) of that Act have been paid (or, if the international application is deemed to be a patent application pursuant to Article 184-20, paragraph (4) of that Act, until after the ruling provided for in that paragraph is made).

(Special Provisions on the Due Date for Payment of Registration Fees)

Article 48-12 With respect to the payment of registration fees in connection with an international application for utility model registration for each year from the first to the third year, the phrase "at the same time as the filing of the application for the utility model registration" in Article 32, paragraph (1) is deemed to be replaced with "within the period for submitting national documents provided in Article 48-4, paragraph (1) (if a request for national processing prescribed in paragraph (6) of the that Article is filed, this means by the time the request for national processing is filed)".

(Restriction on the Timing of Filing a Request for Utility Model Technical Opinion)

Article 48-13 Concerning a request for a utility model technical opinion in connection with an international application for utility model registration, the term "Any person" in Article 12, paragraph (1) is deemed to be replaced with "After the standard time for national processing prescribed in Article 48-4, paragraph (6) has passed, any person".

(Special Provisions on Corrections)

Article 48-13-2 With respect to a correction under the provisions of Article 14-2, paragraph (1) to a foreign language application for utility model registration,

the phrase "the description, scope of claims of a utility model registration, or drawings originally accompanying the application" in paragraph (3) of that Article is deemed to be replaced with "the description, claims, or drawings in the international application as of the international filing date referred to in Article 48-4, paragraph (1)".

(Special Provisions on Grounds for Invalidation)

Article 48-14 In respect of a trial for invalidation of utility model registration in connection with a foreign language application for utility model registration, the phrase "the utility model registration has been made on an application for utility model registration with an amendment that does not comply with the requirements provided for in Article 2-2, paragraph (2)" in Article 37, paragraph (1), item (i) is deemed to be replaced with "the matters stated in the description, scope of claims of a utility model registration, or drawings accompanying the application for a utility model registration in a foreign language as referred to in Article 48-4, paragraph (1) are not within the scope of the matters stated in the description, claims, or drawings in the international application as of the international filing date referred to in Article 48-4, paragraph (1)".

(Mutatis Mutandis Application of the Patent Act)

Article 48-15 (1) The provisions of Articles 184-7 (Amendments Based on Article 19 of the Treaty to a Japanese-Language Patent Application) and Article 184-8, paragraphs (1) through (3) (Amendments Under Article 34 of the Treaty) of the Patent Act apply mutatis mutandis to the amendment of an international application for utility model registration based on the Treaty. In this case, the term "Article 17-2, paragraph (1)" in Article 184-7, paragraph (2) and Article 184-8, paragraph (2) is deemed to be replaced with "Article 2-2, paragraph (1) of the Utility Model Act".

(2) The provisions of Article 184-11 (Special Provisions on Patent Administrators for Overseas Residents) of the Patent Act apply mutatis mutandis to procedures connected with international applications for utility model registration.

(3) The provisions of Article 184-9, paragraph (6) and Article 184-14 of the Patent Act apply mutatis mutandis to international applications for utility model registration.

(International Application Deemed to be an Application for Utility Model Registration by Decision)

Article 48-16 (1) If a refusal as provided in Article 25 (1)(a) of the Treaty or a declaration as provided in Article 25 (1)(a) or (b) of the Treaty has been made

- by a receiving Office referred to in Article 2 (xv) of the Treaty in relation to an international application referred to in Article 2 (vii) of the Treaty (limited to an application for utility model registration) that includes Japan as a designated State referred to in Article 4 (1)(ii) of the Treaty, or if a finding as provided in Article 25 (1)(a) of the Treaty has been made by the International Bureau referred to in Article 2 (xix) of the Treaty, an applicant filing an international application referred to in Article 2 (vii) of the Treaty may propose to the Commissioner of the Japan Patent Office to make the decision provided for in Article 25 (2)(a) of the Treaty within the period specified by Order of the Ministry of Economy, Trade and Industry, pursuant to Order of the Ministry.
- (2) A person making a proposal referred to in the preceding paragraph in connection with an international application that has been filed in a foreign language must submit Japanese translations of the description, claims, drawings (limited to the descriptive text in the drawings), and abstract and of other documents linked with the international application that are specified by Order of the Ministry of Economy, Trade and Industry to the Commissioner of the Japan Patent Office at the time of the proposal.
- (3) If a proposal referred to in paragraph (1) is made, the Commissioner of the Japan Patent Office must decide whether the refusal, declaration, or finding related to the proposal is justified in light of the provisions of the Treaty and the regulations under the Patent Cooperation Treaty.
- (4) If the Commissioner of the Japan Patent Office decides that the refusal, declaration, or finding referred to in that paragraph was not justified in light of the provisions of the Treaty and the regulations under the Patent Cooperation Treaty, the international application subject to that decision is deemed to be an application for a utility model registration filed on the day which would have been accorded the international filing date if no such refusal, declaration, or finding had been made concerning the international application.
- (5) The provisions of Article 48-6, paragraphs (1) and (2), Article 48-7, Article 48-8, paragraph (3), Article 48-9, Article 48-10, paragraphs (1), (3), and (4), and Articles 48-12 through 48-14 of this Act, and Article 184-3, paragraph (2), Article 184-9, paragraph (6), Article 184-12, paragraph (1), and Article 184-14 of the Patent Act apply *mutatis mutandis* to international applications that are deemed to be applications for utility model registration pursuant to the provisions of the preceding paragraph. In this case, the technical replacement of the necessary terms for the *mutatis mutandis* application of the relevant provisions is specified by Cabinet Order.

## **Chapter VIII Miscellaneous Provisions**

(Registration in the Utility Model Register)

Article 49 (1) The following matters are registered in the utility model register kept at the Japan Patent Office:

- (i) the establishment of utility model rights, their transfer, modification under a trust, extinguishment, restoration, or restrictions on their disposal;
  - (ii) the establishment of an exclusive license, its preservation, transfer, modification, extinguishment, or restrictions on its disposal; and
  - (iii) the establishment of a pledge on utility model rights or an exclusive license, its transfer, modification, extinguishment, or restrictions on its disposal.
- (2) The utility model register may be prepared, in whole or in part, on magnetic tape (this includes any other medium onto which certain information can be securely recorded by equivalent means; the same applies hereinafter).
- (3) Beyond what is provided for in this Act, the necessary matters for registration are prescribed by Cabinet Order.

(Issuance of a Certificate of Utility Model Registration)

Article 50 (1) The Commissioner of the Japan Patent Office issues a certificate of utility model registration to the holder of utility model rights when the registration establishing the rights to the utility model is made, or if the transfer of the utility model rights has been registered based on the correction referred to in Article 14-2, paragraph (1) or on the request under the provisions of Article 17-2, paragraph (1).

- (2) Order of the Ministry of Economy, Trade and Industry provides for the re-issuance of a certificate of utility model registration.

(Special Provisions on Utility Model Registrations or Utility Model Rights Covering Two or More Claims)

Article 50-2 In applying the provisions of Article 12, paragraph (2), Article 14-2, paragraph (8) of this Act, Article 97, paragraph (1) or Article 98, paragraph (1), item (i) of the Patent Act as applied mutatis mutandis pursuant to Article 26 of this Act, Article 34, paragraph (1), item (iii), Article 37, paragraph (3), Article 125 of the Patent Act as applied mutatis mutandis pursuant to Article 41 of this Act, Article 132, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to Article 174, paragraph (3) of the Patent Act as applied mutatis mutandis pursuant to Article 41 or Article 45, paragraph (1) of this Act, Article 44 of this Act, Article 176 of the Patent Act as applied mutatis mutandis pursuant to Article 45, paragraph (1) of this Act, or Article 193, paragraph (2), item (v) of the Patent Act as applied mutatis mutandis pursuant to Article 49, paragraph (1), item (i) or Article 53, paragraph (2) of this Act to a utility model registration or utility model rights that cover two or more claims, the utility model registration is deemed to have been made, or the utility model

rights are deemed to exist for each claim.

(Indication of Utility Model Registration)

Article 51 Pursuant to Order of the Ministry of Economy, Trade and Industry, the holder of utility model rights, exclusive licensee, or non-exclusive licensee must endeavor to attach an indication to an article covered by the registered utility model or the packaging of that article showing that the article is covered by a registered utility model (hereinafter the indication is referred to as "indication of utility model registration").

(Prohibition of False Indication)

Article 52 It is prohibited for any person to take the following actions:

- (i) attaching an indication of utility model registration or an indication that is likely to cause confusion with that indication on an article other than one that is covered by a registered utility model or on the packaging of such an article;
- (ii) transferring ownership of, leasing, or displaying for the purpose of transferring ownership of or leasing, an article other than one covered by a registered utility model, or the packaging of the article, which has an indication of utility model registration or an indication likely to be confused with that indication; or
- (iii) showing that an article is covered by a registered utility model in an advertisement, or using a confusing indication, in order to have that article which is not an article covered by a registered utility model be manufactured or used, or for the purpose of transferring ownership of or leasing the article.

(Utility Model Gazette)

Article 53 (1) The Japan Patent Office issues the utility model gazette.

(2) The provisions of Article 193, paragraph (2) (limited to the parts related to items (v) through (vii), item (ix), and item (x)) apply mutatis mutandis to the utility model gazette.

(Fees)

Article 54 (1) The following persons must pay the amount of fees that Cabinet Order specifies in consideration of the actual costs:

- (i) a person filing a request for the extension of a period under the provisions of Article 5, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to Article 2-5, paragraph (1), Article 32, paragraph (3) of this Act, or Article 4 of the Patent Act as applied mutatis mutandis pursuant to Article 14-2, paragraph (5), Article 39-2, paragraph (4), Article 45, paragraph (2), or paragraph (5) of the following Article of this Act, or for a change of the



- date under the provisions of Article 5, paragraph (2) of the Patent Act as applied mutatis mutandis pursuant to Article 2-5, paragraph (1) of this Act;
- (ii) a person filing a notification of succession pursuant to the provisions of Article 34, paragraph (4) of the Patent Act as applied mutatis mutandis pursuant to Article 11, paragraph (2) of this Act;
  - (iii) a person filing a request for reissuance of a certificate of utility model registration;
  - (iv) a person filing a request for issuance of a certificate pursuant to Article 186, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to Article 55, paragraph (1) of this Act;
  - (v) a person filing a request for issuance of a certified copy or an extract of documents pursuant to Article 186, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to Article 55, paragraph (1) of this Act;
  - (vi) a person filing a request for inspection or a copy of documents pursuant to Article 186, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to Article 55, paragraph (1) of this Act; and
  - (vii) a person filing a request pursuant to Article 186, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to Article 55, paragraph (1) of this Act to be issued a document stating the information stored on magnetic tape that constitutes a part of the utility model register.
- (2) A person set forth in the center column of the Appended Table must pay the amount of fees that Cabinet Order specifies within the scope of the amount of money set forth in the right-hand column of the table.
- (3) The provisions of the preceding two paragraphs do not apply if the person that is required to pay the fee pursuant to those provisions is the national government.
- (4) Notwithstanding the provisions of paragraph (1) or (2), if utility model rights or a right to obtain a utility model registration is held under the co-ownership of the national government and persons other than the national government and their respective ownership has been agreed upon, the fee that is payable by the national government and persons other than the national government pursuant to the provisions of paragraph (1) or (2) concerning their own utility model rights or right to obtain a utility model registration (limited to a fee specified by Cabinet Order other than the fee for requesting utility model technical opinion) is the amount arrived at by multiplying the fee provided for in those provisions by the percentage that represents the ownership of each person other than the national government, and the persons other than the national government must pay this amount.
- (5) Notwithstanding the provisions of paragraph (2), if utility model rights or a right to obtain a utility model registration is held under joint ownership of persons including the national government or a person receiving a reduction of

or exemption from the fee for filing a request for a utility model technical opinion (hereinafter referred to as "reduction or exemption" in this paragraph) under the provisions of paragraph (8) or any other laws and regulations and their respective ownership has been agreed upon, for each joint owner other than the national government, the amount of the fee for filing a request for a utility model technical opinion which is payable by those persons pursuant to paragraph (2) concerning their utility model rights or right to obtain a utility model registration is the sum total arrived at by first multiplying the applicable fee for filing a request for utility model technical opinion provided for in paragraph (2) (for a person receiving a reduction or exemption, this means the fee after reduction or exemption) by the percentage that represents that person's ownership, and then adding together the amounts so arrived at, and this sum total is the amount that the persons other than the national government must pay.

- (6) If there is a fraction of less than 10 yen in the amount of the fees calculated pursuant to the preceding two paragraphs, that fraction is discarded.
- (7) The payment of the fee referred to in paragraph (1) or (2) must be made by patent revenue stamps, pursuant to Order of the Ministry of Economy, Trade and Industry; provided, however, that cash payment may be made, if so specified by Order of the Ministry.
- (8) If the person filing a request for a utility model technical opinion on an device claimed in the application for utility model registration or on a registered utility model is the creator of that device claimed in that application for utility model registration, the creator of that registered utility model, or the heir of that creator, and the Commissioner of the Japan Patent Office finds that due to poverty, it would be difficult for the person to pay the fee that must be paid for filing the request for utility model technical opinion pursuant to the provisions of paragraph (2), the Commissioner may reduce that fee or exempt the person from paying the fee, pursuant to the provisions of Cabinet Order.

#### (Return of Fees)

- Article 54-2 (1) If the request is deemed not to have been filed pursuant to the provisions of Article 12, paragraph (7) after a request for utility model technical opinion is filed, the fee the requester has paid pursuant to the provisions of Article 54, paragraph (2) for filing that request is refunded to that person.
- (2) If a demand for a trial for invalidation of utility model registration is withdrawn within the period provided in Article 39-2, paragraph (3) or (5) (or, if the period provided in paragraph (3) of that Article has been extended under the provisions of Article 4 of the Patent Act as applied mutatis mutandis pursuant to Article 39-2, paragraph (4), within the extended period), the fee for

- filing the demand for trial or appeal which the person demanding the trial or appeal has paid pursuant to Article 54, paragraph (2) is refunded to that person upon request.
- (3) A request for a refund of the fee under the provisions of the preceding paragraph may not be filed once six months have passed since the date on which the demand for the trial for invalidation of utility model registration was withdrawn.
- (4) If the intervenor in a trial for invalidation of utility model registration withdraws the application for intervention within 30 days from the receipt of the notice under Article 39, paragraph (5), the fee that the intervenor has paid pursuant to Article 54, paragraph (2) for applying to intervene is refunded to the intervenor upon request.
- (5) The provisions of Article 4 of the Patent Act apply *mutatis mutandis* to the period provided in the preceding paragraph. In this case, the phrase "The Commissioner of the Japan Patent Office" in that Article is deemed to be replaced with "The chief administrative judge".
- (6) Notwithstanding the provisions of paragraph (4), if the intervenor in a trial for invalidation of utility model registration is unable to withdraw the application for intervention within the period provided for in that paragraph due to reasons beyond the intervenor's control, and withdraws the application within 14 days (or within two months, if the intervenor is an overseas resident) after the date on which those reasons cease to exist and no later than six months after the expiration of the period, the fee that the intervenor has paid pursuant to Article 54, paragraph (2) for applying to intervene is refunded to the intervenor upon request.
- (7) A request for refund of the fees under the provisions of paragraphs (4) and the preceding paragraph may not be filed once six months have passed since the date on which the application for intervention was withdrawn.
- (8) If the intervenor in a trial for invalidation of utility model registration does not withdraw the application for intervention, but the demand for the trial is withdrawn within the period provided in paragraph (4) or (6) (or, if the period provided in paragraph (4) has been extended pursuant to Article 4 of the Patent Act as applied *mutatis mutandis* pursuant to paragraph (5), within the extended period), the fee that the intervenor has paid pursuant to paragraph (2) of the preceding paragraph for filing the application to intervene is refunded to the intervenor upon request; provided, however, that this does not apply if the trial proceedings have been continued pursuant to Article 148, paragraph (2) of the Patent Act as applied *mutatis mutandis* pursuant to Article 41.
- (9) A request for refund of the fee under the preceding paragraph may not be filed once one year has passed since the date on which the demand for the trial

for invalidation of utility model registration was withdrawn.

(10) Fees paid in excess or in error are refunded upon the request of the person that paid them.

(11) A request for a refund of the fee under the preceding paragraph may not be filed once one year has passed since the date on which the fee was paid.

(12) If a person making a request for the refund of the fee prescribed in paragraph (2), (4), (6), (8), or (10) is unable to make the request within the period provided in paragraph (3), (7), (9), or the preceding paragraph, due to reasons beyond the person's control, notwithstanding these provisions, the person may make the request within 14 days (or within two months, if the person is an overseas resident) from the date on which those reasons cease to exist, but not later than six months after the period under the provisions have passed.

(Mutatis Mutandis Application of the Patent Act)

Article 55 (1) The provisions of Article 186 (Request for Certificate) of the Patent Act apply mutatis mutandis to a utility model registration.

(2) The provisions of Articles 189 through 192 (Service) of the Patent Act apply mutatis mutandis to services under the provisions of this Act.

(3) The provisions of Article 194 of the Patent Act apply mutatis mutandis to procedures. In this case, the term "examination" in paragraph (2) of that Article is deemed to be replaced with "utility model technical opinion provided for in Article 12, paragraph (1) of the Utility Model Act".

(4) The provisions of Article 195-3 of the Patent Act apply mutatis mutandis to a disposition under the provisions of this Act or under an order based on this Act.

(5) The provisions of Article 195-4 (Restriction on Request for Administrative Review Under the Provisions of the Administrative Complaint Review Act) of the Patent Act apply mutatis mutandis to a trial decision, a ruling to dismiss a written request for trial, or retrial, and to a disposition of which no appeal may be filed in accordance with this Act, or their inaction.

## **Chapter IX Penal Provisions**

(The Crime of Infringement)

Article 56 A person that infringes a utility model right or an exclusive license is subject to imprisonment for a term not exceeding five years, a fine not exceeding 5 million yen, or both.

(The Crime of Fraud)

Article 57 A person who has obtained a utility model registration or a trial decision by means of a fraudulent act is subject to imprisonment for a term not

exceeding one year or a fine not exceeding 1 million yen.

(The Crime of False Indication)

Article 58 A person that violates the provisions of Article 52 is subject to imprisonment for a term not exceeding one year or a fine not exceeding 1 million yen.

(The Crime of Perjury)

Article 59 (1) A witness, expert witness, or interpreter who has sworn an oath pursuant to this Act and then offered a false statement, false expert opinion, or false interpretation to the Japan Patent Office or the court commissioned by the Office is subject to punishment by imprisonment for not less than three months but not more than ten years.

(2) If a person who has committed the crime referred to in the preceding paragraph makes a voluntary confession before the certified copy of the judgment on the case is served or before the trial decision becomes final and binding, the sentence may be reduced or remitted.

(The Crime of Divulging a Secret)

Article 60 A present or former employee of the Japan Patent Office who divulges or misappropriates confidential information about a device claimed in a pending application for utility model registration that the employee has learned in the course of performing their duties is subject to imprisonment for a term not exceeding one year or a fine not exceeding 500,000 yen.

(The Crime of Violating a Confidentiality Protective Order)

Article 60-2 (1) A person that violates an order under the provisions of Article 105-4, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to Article 30 is subject to imprisonment for a term not exceeding five years, a fine not exceeding 5 million yen, or both.

(2) The crime referred to in the preceding paragraph may not be prosecuted unless a first-hand crime report is filed.

(3) The crime referred to in paragraph (1) also applies to a person who commits that crime outside Japan.

(Dual Criminal Liability Provision)

Article 61 (1) If the representative of a corporation, or the agent, employee or other worker of a corporation or individual commits a violation of the provisions set forth in one of the following items in connection with the business of that corporation or individual, in addition to the offender being subject to punishment, the corporation is subject to the fine prescribed in the

relevant item and the individual is subject to the fine prescribed in the respective Articles:

- (i) Article 56 or paragraph (1) of the preceding Article: a fine not exceeding 300 million yen; and
  - (ii) Article 57 or Article 58: a fine not exceeding 30 million yen.
- (2) In the case referred to in the preceding paragraph, a first-hand crime report referred to in paragraph (2) of the preceding Article which is filed against the offender also has effect on the corporation or individual, and a first-hand crime report that is filed against the corporation or individual also has effect on the offender.
- (3) The period of statute of limitations when a fine is imposed on a corporation or an individual pursuant to paragraph (1) in connection with a violation referred to in Article 56 or paragraph (1) of the preceding Article is that for the crimes in these provisions.

(Civil Fines)

Article 62 If a person offers a false statement to the Japan Patent Office or the court commissioned by the Office after having sworn under oath pursuant to the provisions of Articles 71, paragraph (3) of the Patent Act as applied *mutatis mutandis* pursuant to Article 26 of this Act, or pursuant to the provisions of Article 41 of this Act, or Article 174, paragraph (3) of the Patent Act as applied *mutatis mutandis* pursuant to Article 45, paragraph (1) of this Act, which are respectively applied upon *mutatis mutandis* application pursuant to Article 207, paragraph (1) of the Code of Civil Procedure as applied *mutatis mutandis* pursuant to Article 151 of the Patent Act, the person is subject to a civil fine not exceeding 100,000 yen.

Article 63 A person that has been summoned by the Japan Patent Office or the court commissioned by the Office pursuant to the provisions of this Act, but fails to appear or refuses to swear an oath, make a statement, testify, give an expert opinion, or provide interpretation without legitimate grounds for doing so is subject to a punishment by a civil fine not exceeding 100,000 yen.

Article 64 A person that is ordered by the Japan Patent Office or the court commissioned by the Office to submit or present documents or other objects for the purpose of examination or preservation of evidence pursuant to the provisions of this Act, but fails to comply with that order without legitimate grounds for doing so is subject to punishment by a civil fine not exceeding 100,000 yen.

Appended Table (Re: Article 54)

	Person who must pay fees	Amounts
1	A person filing an application for utility model registration	14,000 yen per case
2	A person responsible for the procedures under Article 48-5, paragraph (1)	14,000 yen per case
3	A person making a request under Article 48-16, paragraph (1)	14,000 yen per case
4	A person requesting extension of the period under Article 5, paragraph (3) of the Patent Act as applied mutatis mutandis pursuant to Article 2-5, paragraph (1)	4,200 yen per case
5	A person filing a petition requesting a utility model technical opinion	42,000 yen per case plus 1,300 yen per claim
6	A person correcting a description, scope of claims, or drawings	1,400 yen per case
7	A person undertaking any of the procedures pursuant to the provisions in parentheses of Article 8, paragraph (1), item (i), Article 43-2, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to Article 11, paragraph (1) (including the case where it is applied mutatis mutandis pursuant to Article 43-3, paragraph (3) of the Patent Act as applied mutatis mutandis pursuant to Article 11, paragraph (1)), Article 33-2, paragraph (1), Article 48-4, paragraph (4), or Article 184-11, paragraph (6) of the Patent Act as applied mutatis mutandis pursuant to Article 48-15, paragraph (2) (excluding a person who needs to undertake any of the procedures prescribed in these provisions due to reasons beyond the person's control)	50,000 yen per case
8	A person requesting an advisory opinion under Article 71, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to Article 26	40,000 yen per case
9	A person requesting an award	55,000 yen per case
10	A person requesting the cancel of an award	27,500 yen per case
11	A person filing a request for a trial or retrial	49,500 yen per case plus 5,500 yen per claim
12	A person applying to intervene in a trial or retrial	55,000 yen per case